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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91200832
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BRIGGS & STRATTON CORPORATION,)	
)	Opposition No. 91200832 (Parent)
Opposer,)	
)	Application Serial No. 78924545
v.)	
)	
HONDA GIKEN KOGYO KABUSHIKI)	
KAISHA,)	
)	
Applicant.)	
_____)	
)	
KOHLER CO.)	Opposition No. 91200146
)	
Opposer,)	
v.)	
)	
HONDA GIKEN KOGYO KABUSHIKI)	
KAISHA,)	
)	
Applicant.)	
)	

APPLICANT HONDA GIKEN KOGYO KABUSHIKI KAISHA'S
TRIAL BRIEF
(PUBLIC VERSION – REDACTED)

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I. INTRODUCTION

When it was introduced in 1983, the Honda GX engine (“GX”) was a pioneering engineering feat not only in terms of its performance, but also its aesthetics. The internal engineering features that Honda developed for the GX represented a breakthrough in the small utility engine field, and ultimately gave the GX a reputation for durability, reliability, ease of operation, and fuel efficiency. In parallel with the development of these internal features, Honda tasked its styling designers with creating an instantly recognizable engine that would come to be associated with Honda. They achieved that goal with the numerous aesthetic features that ultimately became the applied-for mark in this proceeding (the “GX Trade Dress”). [REDACTED]

Opposers argue that Honda seeks to claim a trade dress on the basic configuration of a horizontal shaft utility engine, and that such trade dress is functional, lacks secondary meaning, is generic, and was abandoned. These arguments rely chiefly on a fundamental mischaracterization of the GX Trade Dress’s scope – that the applied-for mark claims only the general locations of auxiliary engine components. Opposers’ mischaracterization of the mark ignores the specific aesthetic features and complementary styling of the GX’s four main components that give the engine its overall “cubic look.” It is the combination of these aesthetic styling elements that comprises the GX Trade Dress. When viewed in this proper lens, Opposers’ arguments fail to address the very trade dress at issue.

Opposers’ contention that the applied-for mark is functional is undercut by the many alternative designs in the marketplace that successfully compete with the GX, as well as largely uncontradicted evidence in the record that the GX’s stylistic features do not affect the performance, quality, or cost of the engine. Likewise, Opposers have failed to demonstrate that the GX Trade Dress lacks secondary meaning, is generic, or has been abandoned where an abundance of evidence establishes Honda’s continued exclusive use of the GX Trade Dress, extensive sales and advertising of the GX prominently featuring the GX Trade Dress, established market share and industry recognition, and diligent, successful attempts by Honda to protect its intellectual property against widespread, intentional copying. For these reasons, and

those set forth below, Honda respectfully requests that the Board permit the registration of the GX Trade Dress.

II. STATEMENT OF THE ISSUES

1. Whether the styling elements that comprise the GX Trade Dress are functional.
2. Whether the GX Trade Dress has acquired distinctiveness.
3. Whether Opposers have established that the GX Trade Dress is generic.
4. Whether Opposers have established that Honda abandoned the GX Trade Dress.

III. DESCRIPTION OF THE RECORD

Honda generally agrees with Opposers' "Summary of the Record," in Opposers' Trial Brief ("Opp. Br.") at 10-12, except as set forth below:

1. Honda disagrees with Opposers' characterization of the documents contained in Opposers' Second Notice of Reliance, Exhibit G, as being "[i]nternet pages showing 3rd party use of similar engines." Opp. Br. at 10, ¶ A.5.a.
2. Honda disagrees with Opposers' characterization of the documents contained in Opposers' Thirteenth Notice of Reliance, Exhibit TT, as being "relevant to abandonment of the applied-for trademark." Opp. Br. at 10, ¶ A.5.b.
3. Complete docket numbers for Honda's trial testimony include: Conner, S. (Dkts. 186-189); Fujita, M. (Dkts. 200, 202); Mantis, G. (Dkts. 184-85); Mieritz, J. (Dkts. 196-97). Opp. Br. at 11, ¶¶ B.1.a-d.
4. An accurate description of Applicant's Eighth Notice of Reliance, Exs. J-L, is "official records from *Powertrain, Inc., et al., v. American Honda Motor Co., Inc.*, 1:03-cv-00688-MPM (N.D. Miss. Oct. 23, 2007); and *American Honda Motor Co., Inc. v. The Pep Boys, et al.*, 2:05-cv-08879-WDK-VBK (C.D. Cal. Nov. 13, 2007)." Opp. Br. at 12, ¶ B.5.

IV. EVIDENTIARY OBJECTIONS

Honda objects to the admission of foreign intellectual property filings and to certain testimony of Opposers' functionality expert, John Reisel, as set forth in Appendix A. Honda's responses to Opposers' evidentiary objections are set forth in Appendix B.

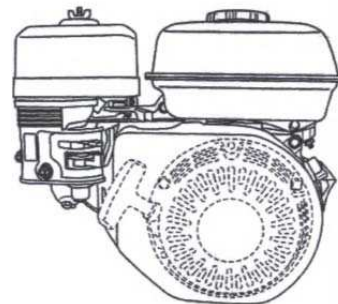
Honda maintains its objection to portions of fact witness Jeff Whitmore’s trial testimony. *See* Dkt. 129 (July 17, 2015 Motion to Strike Improper Expert Testimony of Fact Witness Jeff Whitmore).

V. STATEMENT OF FACTS

A. The GX Trade Dress

The trade dress at issue is depicted in the Application (App. Ex. 6), as shown on the right. As set forth in the description:

The mark consists of the configuration of an engine with *an overall cubic design*, with a slanted fan cover, the fuel tank located above the fan cover on the right, and the air cleaner located to the left of the fuel tank. The air cleaner cover features *a cube shape with beveled top outside edges, and a belt-like area on the lower portion of the cover encompassing the entire circumference and the top of the belt-like area is aligned with a rib of the fuel tank*. The carburetor cover features *four ribs long its outside edge and a recessed area where control levers are located*. The fuel tank is *roughly rectangular*[.] The engine features a *beveling that runs around its top circumference*.



Id. (emphasis added). The drawing and the description together reflect the many deliberate styling choices that the Honda styling team made in designing the four main components in order to achieve an overall “cubic” look,¹ including:

(1) Fuel Tank: The GX fuel tank, located on the top right side of the engine, has a distinct rectangular shape consisting of a straight line at the bottom of the tank, slightly angled walls (with the inside wall being more vertical than the outside wall), a horizontal seam slightly below the center of the tank, and beveled top outside edges. Fujita 26:13-30:23.

(2) Air Cleaner Cover: The GX air cleaner cover, located to the left of the fuel tank, has a distinct cubic shape, and includes beveled top outside edges and a horizontal belt-like area at the bottom,

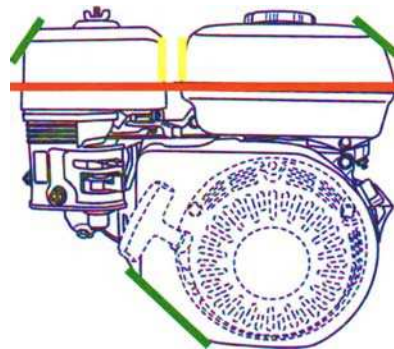
¹ Contrary to Opposers’ suggestion, Honda has proffered this definition of the trade dress consistently throughout the prosecution as well as this proceeding. *See, e.g.*, Mar. 4, 2009 Resp. to Office Action (“O.A.”) (submitting declarations by functionality experts identifying the numerous ornamental features of the applied-for mark); Dkt. 77 (Honda’s Opp. to Opposers’ Motion for Summary Judgment). Honda’s statement during prosecution that “while there are functional portions of the design, the shape and position of such portions constitute part of the design” (Aug. 4, 2010 Resp. to O.A.) is not inconsistent. In the proper context, it is clear that this statement is in reference to the disclaimer for levers, bolts, nuts and caps. Further, while the shape and position of the component parts is part of the GX Trade Dress, they do not alone comprise the trade dress. Honda has consistently claimed a trade dress on the overall cubic look achieved by the many styling features of the main components, which have the shape and position shown in the drawing.

with the upper edge of the belt-like area aligning with the seam on the fuel tank to create a single horizontal line that runs across the entire front surface of the engine. *Id.* at 36:5-37:22.

(3) Carburetor Cover and Controls: The GX carburetor cover, located below the air cleaner, includes a left vertical edge, horizontal lines at the top and bottom that form right angles with the left edge, four horizontal ribs along the body, and a recessed area for the controls. *Id.* at 40:14-41:19, 42:25-43:10.

(4) Fan Cover: The fan cover, located at the bottom right side of the GX, includes a slanted portion on the lower left edge, a vertical line on the upper left edge that forms a square upper left corner, a straight upper edge that flows into a semi-circular right side, and a horizontal bottom edge. *Id.* at 44:11-45:12.

Viewed as a whole, the complementary appearance of these components creates the *overall* distinctive cubic look of the GX. For example, the fuel tank and air cleaner cover have complementary beveling and shapes – the top left angle of the air cleaner cover mirrors the angle of the right side of the fuel tank (shown in green); the right vertical line of the air cleaner cover mirrors the left vertical line of the fuel tank (shown in yellow); the air cleaner cover and fuel tank have the same height and horizontal lines to achieve a continuous and complementary appearance (shown in orange). Fujita 36:5-18. Similarly, the carburetor cover and fan cover have numerous straight lines and right angles intended to complement one another. In addition, the particular angle of the slant on the fan cover corresponds with the beveling on the upper right corner of the fuel tank (both shown in green), as well as the lower portion of the carburetor. As set forth in more detail below, there is no serious dispute that these numerous styling features of the GX Trade Dress are ornamental and do not affect the function, quality, performance, or competitiveness of the engine. *Id.* at 16:20-17:2, 30:14-23, 36:22-37:22, 40:24-41:19, 44:11-45:12; Mieritz 70:2-71:16.



Opposers characterize the GX Trade Dress as encompassing the appearance of any inclined cylinder, horizontal shaft utility engine with the same relative positions of its major components – the fuel tank, air cleaner cover, carburetor cover, and fan cover – as the GX. Although Opposers assert that their characterization is based on the description of the mark as set forth in the Application, they ignore not only the many ornamental features shown in the drawing, but also the ornamental features outlined in the description (emphasized above). As a result, Opposers’ characterization reflects a fundamental misrepresentation of the GX Trade Dress.

B. The Design And Development Of The GX

In 1983, Honda introduced an innovative overhead valve (“OHV”) engine design – the GX – which was the result of three years of development [REDACTED]

[REDACTED]. In designing the GX, Honda’s primary performance goals were to create an engine that was more fuel-efficient, lighter, and more compact than its predecessor, the “ME” engine, which used a side-valve configuration. App. Ex. 189A at 7; [REDACTED]

[REDACTED] The performance design group, tasked with designing the functional aspects of the engine, turned to an OHV configuration, which was more powerful, more efficient, and more durable than the side-valve configuration of the ME. App. Ex. 189A at 7-10. The standard OHV engine design at the time, however, was larger and required more parts, making it heavier and more costly to build than the traditional side-valve configuration. *Id.* at 10. The performance design team overcame these drawbacks, largely by creating a new engine concept: an OHV engine with an inclined cylinder. *Id.* at 19. This new concept offered all the advantages of an OHV engine (higher performance and better fuel economy), with the added benefits of an inclined cylinder (lower center of gravity, reduced vibration, and more compact size). *Id.* [REDACTED]

[REDACTED]

To protect its investments in its innovations (both performance and aesthetic), Honda applied for and obtained a design patent on the external styling of the GX, and utility patents on various performance-related aspects of this new inclined-cylinder OHV engine design. *See, e.g.*, Opp. Exs. Q (utility patent directed to an internal bearing support member that aids in oil flow), S (utility patent directed to an internal canister for absorbing fuel vapor); App. Ex. 40 (design patent displaying GX Trade Dress).

C. The Success And Promotion Of The GX

[REDACTED]

[REDACTED]

² Honda's investment in external styling is not atypical in the industry. [REDACTED]

[REDACTED]; *see*
also, *e.g.*, App Exs. 78-83; Opp Exs. 37-44. [REDACTED]

[REDACTED] The “hero shot” is either the focal point of Honda’s advertisements for the GX, (*e.g.*, App. Exs. 81-83; Opp. Exs. 41-42), or is featured at the foot of an advertisement, as if it were a logo (*e.g.*, App. Exs. 78-79, 83; Opp. Exs. 38-43). Honda’s print advertisements have featured the “hero shot” consistently over the past 15 years, and the GX Trade Dress has appeared in other Honda and OEM promotional materials for decades. *See, e.g.*, App. Exs. 68-69, 71-72, 78-83; Opp. Exs. 31-32, 38-43. None of Honda’s advertisements attributes any of the performance benefits of the GX to the appearance of the engine.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

⁴ [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

D. The Success Of The GXs Led To An Influx Of Copy Engines

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]. These engines (two examples

left and center) were confusingly similar to the GX (right) despite coming in a variety of colors.



App. Ex. J, Exhibit A at 25



App. Ex. 93 at AHGXC000136



App. Ex. 74

Id. at 72:9-15; *see also, e.g.*, App. Exs. 93 at AHGXC000123, 94 at AHGXC000046, 101 at AHGX000088; App. Ex. J, Exhibit A at 3-4, 26, and 54 (additional engine photographs).

[REDACTED]

[REDACTED]

[REDACTED]

Honda sent hundreds of cease and desist letters and initiated trade dress infringement lawsuits against several manufacturers and distributors of copy engines.

Id. at 75:3-80:17; App. Exs. 90-91, J-M. One of these cases, *Powertrain, Inc., et al., v. American Honda Motor Co.*, 1:03-cv-00688-MPM (N.D. Miss. Oct. 23, 2007), ultimately went to trial, and resulted in a jury verdict and permanent injunction in Honda’s favor. App. Exs. 91, J-L. The jury in *Powertrain* found that “the trade dress of [Honda’s] GX series engines is protectable (*i.e.*, that the trade dress is non-functional and has secondary meaning).” App. Ex. 91; [REDACTED]; App. Exs. J-L. In the two other cases – *American Honda Motor Co., Inc. v. The Pep Boys, et al.*, 2:05-cv-08879-WDK-VBK (C.D. Cal. Nov. 13, 2007) and *American Honda Motor Co., Inc. v. General Power Products, LLC, et al.*, CV06-06305-GAF (FMOx) – [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

E. Filing And Prosecution Of Honda’s Trademark Application

Honda filed its trademark application in 2006, in the midst of its disputes with copy engine manufacturers and distributors. *See* July 7, 2006 Trademark Application. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED].

The Patent and Trademark Office (“PTO”) thoroughly examined the GX Trade Dress during prosecution, and its ultimate approval for publication reflects the strength of the evidence offered by

Honda. Responding to the examiner's request for "evidence that the applied-for mark has acquired distinctiveness," (Dec. 8, 2006 O.A.), Honda provided the PTO with: (1) product brochures, images from a third-party website, and online advertisements; (2) declarations from numerous engine distributors who confirmed that the Honda GX's "appearance and shape is well known and famous in the construction and power equipment industry as being the engine appearance and shape of engines sold by Honda"; and (3) a declaration from Honda's Senior Vice-President of the Power Equipment Division, Steven Scott Conner, that detailed Honda's revenue and advertising expenditures for the GX. June 11, 2007 Resp. to O.A. Based on this evidence, the examiner determined that Honda "provided a showing of acquired distinctiveness." Feb. 5, 2010 O.A.; *see also* July 25, 2008 Memo. re: Letter of Protest ("A configuration refusal was made that applicant overcame with a showing of distinctiveness.").

Honda similarly provided strong evidence that the GX Trade Dress was nonfunctional. For example, the examiner reviewed U.S. Patent Nos. 6,331,740; 6,362,533; and 6,489,690, and suggested that the GX Trade Dress might "enable the applicant's engines to fit into a more compact space and to have a lower center of gravity."⁵ Sept. 2, 2008 O.A. In response, Honda submitted the declarations of functionality experts – including Mr. James Mieritz, its functionality expert in this opposition proceeding – describing the numerous ornamental features of the applied-for mark identified above. Mr. Mieritz explained that none of those features "makes it easier for such an engine to fit into a compact space or [give] the engine . . . a lower center of gravity than other comparable engines." Mar. 4, 2009 Resp. to O.A. at 1-2, Exs. B-C. Ultimately, the examiner found that "[t]he evidence provided by [Honda] points out several nonfunctional features of its proposed mark: the overall 'cubic' look of the engine; the shape of the air cleaner housing; the design of the carburetor cover; the shape and size of the fuel tank; the combined and complementary shape of the fuel tank and air cleaner housing; and the position and orientation of the major engine components." Feb. 5, 2010 O.A.

⁵ Honda also disclosed U.S. Patent No. 4,813,385 to the examiner. Mar. 4, 2009 Resp. to O.A. at 8.

F. Allowing The GX Trade Dress To Be Registered As A Trademark Will Not Hinder Competition

Contrary to Opposers' assertion that Honda is trying to extend the monopoly afforded by its utility patents, [REDACTED]

[REDACTED]. Indeed, as Opposers point out, there are numerous examples in the market of engines having components in those same general locations. Opp. Br. at 24-25; [REDACTED]

As Opposers admit, Honda's competitors have multiple options to visually differentiate their engines, despite using the same general engine configuration (with the air cleaner on the upper left side, the fuel tank to right of it, a carburetor cover below the air cleaner cover, and a slanted fan cover below the fuel tank). Kohler's senior product manager and Rule 30(b)(6) witness, Mr. Litt, agreed that "[REDACTED] and Opposers' expert, Dr. Reisel, conceded that engines may be compact yet differ in overall appearance. Reisel 154:5-24; *compare id.* at 82:7-12 (conceding App. Ex. 20 differed in appearance from the GX); *with id.* at 96:21-23 (agreeing that engines in App. Exs. 17 and 19-32 "are compact").

Honda's witnesses outlined the visual differences between numerous engines that compete with the GX (including many of the engines Opposers depict in their trial brief at page 24). *See* Mieritz 82:1-92:10 (describing differences between GX and engines by Subaru, Briggs, Kawasaki, and Kohler in App. Exs. 17, 21, 23, 24, 43, 44); [REDACTED] *see also* App.

Exs. C, E, at Answer 10 (Opposers identifying its competitors). Further, Opposers' own witnesses acknowledged the visual differences between engines. [REDACTED]

[REDACTED] Reisel 101:14-130:20 (describing differences between the GX and competitor engines offered by Subaru, Briggs, Kawasaki, Champion, EquipSource/Lifan, All-Power, and Kohler as shown in App. Exs. 17, 20-27, 29-32). For the Board's convenience, Honda's **Appendix C** provides a table of this testimony on each third party engine.

As to Opposers' engines specifically, [REDACTED]

[REDACTED]; Mieritz 15:20-16:7 (former Briggs engineer confirming Briggs' desire to achieve a "family look"). [REDACTED]

[REDACTED] They have also obtained design patents covering a variety of different engine styles, which also depict a basic engine configuration. *See, e.g.*, App. Exs. 2, 16, 37-39; [REDACTED]

VI. ARGUMENT

A. Opposers Have Failed To Establish That The GX Trade Dress Is Functional

Opposers base their entire functionality argument on a fundamental misstatement of the GX Trade Dress as comprising the general configuration of an inclined cylinder OHV engine. With this erroneous characterization, Opposers argue that the GX Trade Dress is functional in light of Honda utility patents describing the benefits of an inclined cylinder OHV configuration, and then assert that Honda cannot meet its burden on the other factors relevant to functionality. Opposers' argument suffers from several fatal defects.

First, Opposers have the burden of establishing a prima facie case of functionality, and only if they meet this burden must Honda establish non-functionality based on a preponderance of the evidence. *See Valu Eng'g, Inc. v. Rexnord Corp.*, 61 U.S.P.Q.2d 1422, 1429 (Fed. Cir. 2002). Opposers cannot meet their burden where they misstate the very trade dress at issue. *Second*, Opposers misapply the *Morton-Norwich* factor addressing Honda's utility patents – the test is not, as Opposers suggest, whether the GX Trade Dress is depicted in any utility patents, but whether those utility patents disclose *the utilitarian advantages of the applied-for trade dress*. *See In re Morton-Norwich Prods.*, 213 U.S.P.Q. 9, 15 (C.C.P.A. 1982). None of the utility patents cited by Opposers ascribes any benefit to specific features of the GX Trade Dress. *Third*, Opposers largely misapply and/or ignore the remaining *Morton-Norwich* factors, each of which supports a finding that the GX Trade Dress is non-functional. For these reasons and as explained more fully below, Opposers have failed to establish a prima facie case of functionality.

1. Opposers Cannot Carry Their Burden By Misstating Honda's Trade Dress

Describing the applied-for mark as the basic configuration of an inclined cylinder OHV engine, Opposers argue that the GX configuration is functional because it creates a compact, cubic shape that fits within OEM requirements. Opp. Br. at 30, 36. Opposers deliberately confuse Honda's applied-for trade dress (*i.e.*, the overall stylistic look of the GX) with the GX's basic configuration, and this mistake is compounded by Opposers' additional misapplication of de jure functionality and de facto functionality

(an error repeated from their summary judgment briefing, *see* Dkts. 48, 77). As a result of these mistakes, Opposers' functionality argument misses the mark.

“[I]n general terms, a product feature is functional, and cannot serve as a trademark, if it is essential to the use or purpose of the article or if it affects the cost or quality of the article, that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.” *Qualitex Co. v. Jacobson Prods. Co.*, 34 U.S.P.Q.2d 1161, 1163-64 (U.S. 1995). Implicit in the functionality inquiry is a clear understanding of the “product feature” at issue – Honda does not seek protection of the basic configuration of an engine as suggested by Opposers; rather, as depicted and described in Honda's Application, the GX Trade Dress comprises the specific styling elements of each component (*e.g.*, the complementary lines, beveling, and shapes), which together express the overall distinctive cubic look of the GX Trade Dress.

In generalizing Honda's trade dress as a standard compact engine configuration, Opposers ignore that “the critical question is the degree of utility present in the overall design *of the mark*,” not the general utility of the product itself. *In re Becton, Dickinson & Co.*, 102 U.S.P.Q.2d 1372, 1375-76 (Fed. Cir. 2012) (emphasis added). This “critical question” draws a distinction between “de facto” and “de jure” functionality. “[D]e facto functional[ity] means that the design of a product has a function, *i.e.*, a bottle of any design holds fluid. De jure functionality, on the other hand, means that the product is in its particular shape *because it works better in this shape*.” *In re R.M. Smith, Inc.*, 222 U.S.P.Q. 1, 3 (Fed. Cir. 1984) (emphasis added).

Importantly, the fact that a product itself has a function, *i.e.*, is de facto functional, “is irrelevant to the question of whether a mark as a whole is functional so as to be ineligible for trademark protection.” *In re Becton, Dickinson*, 102 U.S.P.Q.2d at 1376-77. Rather, where a mark is composed of functional and non-functional features, the determination of whether “an overall design is functional should be based on the superiority of the design as a whole, rather than on whether each design feature is ‘useful’ or ‘serves a utilitarian purpose.’” *Id.* (quotations omitted); *Sunbeam Prods. v. W. Bend Co.*, 44 U.S.P.Q.2d 1161, 1164 n.3 (5th Cir. 1997) (“[T]he inquiry does not focus on isolated elements of the dress, but on whether a

combination of features creates a distinctive visual impression, identifying the source of the product.”). Stated simply, the question is whether the trade dress has a separate overall appearance which is non-functional.

In arguing that the GX Trade Dress is simply a compact inclined cylinder OHV engine configuration, Opposers misapply the “overall appearance” inquiry. Indeed, when described at a high enough level, the appearance of any functional object becomes de facto functional – for example, the specific external design and lines of a sports car may create an overall distinctive look subject to trade dress protection; however, if it is characterized generally as a vehicle with four wheels, two doors, and windows, such basic design serves a function and would encompass almost any vehicle. This is precisely what Opposers are doing by describing the GX Trade Dress as a basic engine configuration. But as the testimony of Honda’s and Opposers’ own witnesses demonstrates: (1) an engine may have the same components as the GX arranged in roughly the same manner, and still look different than the GX Trade Dress (Reisel 154:5-24); (2) there are “a lot of degrees of freedom” as to the exact locations of each component (Fujita 34:12-23; Mieritz 21:18-22) [REDACTED]

[REDACTED]

When applied to the actual GX Trade Dress depicted in Honda’s Application, Opposers’ functionality argument fails to address the complementary lines, angles, and beveling of each component that creates the distinct overall cubic look of the GX Trade Dress. *See* Opp. Br. at 36. This failure is for good reason – Opposers’ own witnesses agreed that the styling of each component that together express the GX Trade Dress is ornamental and does not affect performance, cost, or quality of the engine.

[REDACTED]

[REDACTED]

[REDACTED] Further, Opposer’s expert Dr. John Reisel – who had never analyzed the external appearance of an engine prior to this case – agreed that the angle and shape of the beveling of the fuel tank were not functional and offered

no opinion as to the location of the seam of the fuel tank being below center. Reisel 108:19-109:22, 115:12-22.

As to the air cleaner cover, [REDACTED]

[REDACTED]

[REDACTED]

Further, Dr. Reisel did not offer any opinion with respect to many of these styling features, instead opining only as to the general location and shape of the air cleaner cover. Reisel 119:23-120:13.

As to the carburetor cover's straight lines and four horizontal ribs, Opposers offered no opinion whatsoever, and instead Dr. Reisel opined only that the recessed area for the controls protects it from breakage. Reisel 132:13-134:15.

As to the fan cover, Dr. Reisel admitted that its straight top and left sides are "not necessary," and agreed that the ideal fan cover shape would be rounded at the bottom instead of flat as in the GX. *Id.* at 99:12-100:21. Also, while Dr. Reisel asserted generally that a slant on the lower left side of the fan cover is functional (*see id.* at 38:20-40:1), he admitted that "the exact specific angle does not need to necessarily be the same" as the GX, and that the optimal angle of the slant will vary based on the exact size and configuration of the engine. *Id.* at 97:25-99:11.

Finally, as to the GX's overall look, Dr. Reisel admitted that many of its complementary lines and angles are purely ornamental, including: (1) the similar beveling on the air cleaner cover and fuel tank (*id.* at 138:11-15); (2) the similar angles on the top right of the fuel tank and lower left of the fan cover (*id.* at 141:14-142:2); and (3) the straight line created by the lower left side of the fan cover lining up with the carburetor cover. *Id.* at 142:3-143:1 [REDACTED]

[REDACTED]

⁶ These many stylistic decisions, which give the GX its overall cubic look, set this case apart from those cases suggesting that a few insignificant non-functional features are insufficient to establish that an overall product design is non-functional. *See, e.g.,* Opp. Br. at 32 (citing *Petersen Mfg. Co. v. Central Purchasing, Inc.*, 222 U.S.P.Q. 563 (Fed. Cir. 1984), and *Secalt S.A. v. Wuxi Senxi Constr. Mach. Co.*, 101 U.S.P.Q.2d 1553 (9th Cir. 2012)). Indeed, "the inquiry does not focus on isolated elements of the dress, but on whether a combination of features creates a distinctive visual impression, identifying the source of the product." *Sunbeam Prods.*, 44 U.S.P.Q.2d at 1164 n.3.

In sum, Opposers have misstated the GX Trade Dress and as a result have failed to present any evidence addressing the functionality of the mark as shown and described in the Application. On this basis alone, Opposers have failed to carry their burden.

2. The *Morton-Norwich* Factors Support a Finding of Non-Functionality

Opposers have also failed to carry their burden of establishing that the *Morton-Norwich* factors support a finding of functionality. *See In re Morton-Norwich Prods.*, 213 U.S.P.Q. at 15-16 (outlining factors). Rather, the *Morton-Norwich* factors, when applied to the properly-defined trade dress, establish that the GX Trade Dress is non-functional.

a) The Utility Patents And Foreign Applications Cited By Opposers Do Not Claim The Features Of The GX Trade Dress

Based on Opposers' mischaracterization of the applied-for mark, Opposers argue that various Honda U.S. utility patents and Japanese utility model applications establish that the GX Trade Dress is functional because they describe the general location and/or shape of some of the engine components. Opposers' reliance on these patents and Japanese utility model applications is misplaced and misapplies the law on utility patents. In addition, Opposers ignore Honda's design patent directed to the appearance of the GX.

Contrary to Opposers' claims, the fact that a utility patent depicts the trade dress at issue is not evidence that the trade dress is functional; rather, the patent must attribute some functional significance to the trade dress features, either by claiming those specific features or by describing their purpose. *See TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 58 U.S.P.Q.2d 1001, 1005, 1007 (U.S. 2001) (holding that "a utility patent is strong evidence that *the features therein claimed* are functional" and that the specification is relevant "to see if the feature in question is shown as a useful part of the invention" (emphasis added)). In other words, a patent's mere inclusion of "arbitrary, incidental, or ornamental aspects of features of a product" does not suggest that those features are functional *unless the patent*

ascribes some purpose or benefit to them. See id. at 1007. As 1 McCarthy on Trademarks and Unfair Competition § 7:89.30 (4th ed.), explains:

[A] utility patent must be examined in detail to determine whether the disclosed configuration is really primarily functional or just incidentally appears in the disclosure of a patent. *There is no doubt that many non-functional shapes and configurations happen to be described or pictured as an incidental detail in functional patents.*

(emphasis added).

None of the patents or Japanese utility model applications relied on by Opposers claims or attributes any functional benefit to the specific elements of the GX Trade Dress that combine to create the overall cubic look shown in the Application.⁷ Opposers have failed to meet their burden of showing that this evidence is relevant, and in fact for most Opposers provide no analysis whatsoever.

The one U.S. patent Opposers do address – U.S. Patent No. 4,813,385 (“the ’385 patent”)⁸ – Honda disclosed during prosecution (Mar. 4, 2009 Resp. to O.A.), and the examiner did not raise any concerns regarding this patent. Indeed, the ’385 patent does not describe the overall cubic look of the GX Trade Dress, much less attribute any functional significance to it. Rather, the ’385 patent is directed to a “general-purpose internal combustion engine” with a pre-cleaner (a component that is not even part of the

⁷ This lack of disclosure of a functional benefit to the GX Trade Dress distinguishes this case from those in which utility patents *actually disclosed a purpose to the trademark at issue*. See, e.g., *Traffix Devices*, 58 U.S.P.Q.2d at 1005 (determining functionality where “[t]he central advance claimed in the expired utility patents here is the dual-spring design, which is an essential feature of the trade dress MDI now seeks to protect”); *In re Becton Dickinson*, 102 U.S.P.Q.2d at 1377 (upholding functionality determination where utility patent “teaches the functional benefits of two important features of [the] proposed mark”); *In re Bose Corp.*, 227 U.S.P.Q. 1, 5 (Fed. Cir. 1985) (determining that patents disclosing ease of manufacture of “five-sided speaker enclosure,” which was the trademark sought to be registered, supported functionality determination).

⁸ Opposers’ failure to address the additional U.S. patents is for good reason – the PTO considered several of them during prosecution of the applied-for mark (see Feb. 5, 2010 O.A.), and concluded they do not describe the GX Trade Dress. Rather, some of the patents describe only the general shape of some of the components (e.g., “fan cover has a generally cylindrical shape” (U.S. Patent No. 6,525,430, Opp. Ex. R; see also U.S. Patent No. 6,489,690, Opp. Ex. O, U.S. Patent No. 6,331,740, Opp. Ex. P); “fan cover [] bulges greatly along the engine cylinder” (U.S. Patent No. 6,363,533, Opp. Ex. N)). Further, the inventions of these patents relate to other aspects of the GX that have nothing to do with the ornamental features sought to be protected here and that can be used in numerous engine designs (including, but not limited to the GX), such as a canister for absorbing fuel vapor (U.S. Patent No. 7,086,389, Opp. Ex. S), and an internal bearing support member that aids in oil flow (U.S. Patent No. 6,941,919, Opp. Ex. Q). Finally, many patents concern generators, which are irrelevant to the applied-for mark. See Opp. Exs. N-P, R.

GX Trade Dress) attached to the air cleaner. Opp. Ex. M, col. 2:10-17. The '385 patent further describes and depicts the *basic* layout of the engine components. *Id.* at claim 1. The only reference to the appearance of the components themselves is a statement that the fuel tank, air cleaner, and muffler (also not part of the GX Trade Dress) are “substantially rectangular as viewed *in plan*,” which the specification defines as viewed from above. *Id.* at claim 2 & col. 3:31-32 (referring to FIG. 2 showing engine from above as “a plan view”). Nowhere in the claims, specification, or prosecution history does the '385 patent ever discuss the shape of any components as viewed from the front as in the Application, or discuss any of the aesthetic features of those components that make up the GX Trade Dress. And as even Opposers admit, components may be “roughly rectangular” yet still present a variety of styling options. Reisel 114:11-115:1.

Opposers also rely on Figure 1 of the '385 patent, which provides “a perspective view of a general-purpose internal combustion engine according to the present invention.” *See* Opp. Ex. M, col. 3:28-30. But the '385 patent neither describes nor ascribes any benefit to the specific styling of the components depicted in Figure 1, and thus does not support a finding that the applied-for mark is functional. *See TrafFix Devices*, 58 U.S.P.Q.2d at 1007; *Dogloo, Inc. v. Doskocil Mfg. Co.*, 35 U.S.P.Q.2d 1405, 1410 (C.D. Cal. 1995) (determining trade mark was non-functional even though it was “incidentally” illustrated in utility patents).

Opposers' reliance on Japanese utility model applications as purportedly disclosing a general purpose engine “with the same shape and configuration” as the applied-for trade dress is even more misplaced. Opp. Br. at 33. As set forth in Appendix B, Honda objects to these applications as irrelevant foreign intellectual property filings. In addition, just like the U.S. utility patents on which Opposers rely, nowhere do these Japanese utility model applications discuss the GX's specific styling or describe any benefit of the ornamental features comprising the GX Trade Dress. *See* Opp. Exs. BB, EE, FF.⁹ Rather, Opposers rely on these Japanese applications for the same improper reasons as the '385 patent – they

⁹ Opposers submit additional Japanese utility model applications as evidence, yet they provide no analysis as to how they allegedly describe the GX Trade Dress. *See, e.g.*, Opp. Exs. T-AA, CC, DD, GG. Thus, Opposers did not carry their burden of establishing how these foreign applications establish functionality of the GX Trade Dress.

include figures depicting some aspects of the GX Trade Dress, and describe or claim the *general* shape and/or placement of components. *See* Opp. Br. at 19-22 (describing Japanese utility model applications as disclosing the general location of each component of the engine). These figures have even *less* significance to the GX Trade Dress than the '385 patent – for example, the figures in Japanese Applications S62-33961 and 63-35160 (Opp. Exs. BB, FF) do not include the carburetor cover features *or* the belt-like area of the air cleaner cover of the GX Trade Dress, and the figure in Japanese Application 63-32344 (Opp. Ex. EE) does not depict the engine from the front. Indeed, Opposers' own expert Dr. Reisel agreed that none of these Japanese utility model applications requires the individual engine components to look like those in the GX Trade Dress. Reisel 159:23-165:9. And as explained above regarding the '385 patent, to the extent these figures depict some aspects of the GX Trade Dress, they are insufficient to establish functionality because the applications do not otherwise ascribe any benefits to the applied-for mark.

While the utility patents and foreign utility model applications cited by Opposers are not evidence that the GX Trademark is functional, Honda's expired design patent on the GX is *presumptive evidence of non-functionality*. Specifically, because a design must be ornamental for a design patent to issue, *see* 35 U.S.C. § 171 (1952), the existence of a design patent creates a presumption that the design is non-functional. *In re Morton-Norwich*, 213 U.S.P.Q. at 17 n.3; *Fuji Kogyo Co. v. Pac. Bay Int'l Inc.*, 79 U.S.P.Q.2d 1894, 1900 (6th Cir. 2006). In 1986, Honda obtained a design patent on the external appearance of the GX, and it depicts nearly all the features of the GX Trade Dress. *See* App. Ex. 40. Significantly, Opposers too have obtained design patents covering a variety of different designs, which also depict the "basic configuration" (*i.e.*, fuel tank on top right; air cleaner cover on top left; slanted fan cover; location of carburetor cover) they now insist is a functional bar to registering the GX Trade Dress. *See, e.g.*, App. Exs. 2, 16, 37, 38; *see also* [REDACTED]. Honda's and Opposers' design patents confirm that, notwithstanding the *de facto* functionality of a general purpose engine, such as the GX, the specific styling of such an engine is ornamental and not dictated by function.

b) Available Alternative Designs Provide The Same Performance As The GX

Opposers raise two arguments regarding alternative designs to the GX Trade Dress. *First*, Opposers argue that this factor is irrelevant given Opposers’ “overwhelming evidence” of functionality. *See* Opp. Br. 36-38. But, this argument was previously made by Opposers, and rejected by the Board because it misstates the law. *See* Dkt. 75 at 13; *Valu Eng’g*, 61 U.S.P.Q.2d at 1427 (stating that although a tribunal need not consider the availability of alternative designs where it finds the design functional based on other considerations, that does not mean “that the availability of alternative designs cannot be a legitimate source of evidence to determine whether a feature is functional in the first place”).

Second, reflecting their fundamental misrepresentation of the trade dress at issue, Opposers argue that the only alternative designs Honda presented are engines with a front-mounted panel air cleaner, which they contend do not work as well as the top-mounted air cleaner on the GX Trade Dress. Opp. Br. at 37-38. As explained throughout Honda’s trial brief, the GX Trade Dress is not simply the general configuration of the engine as Opposers contend, but rather the GX’s distinctive “cubic” look with its many straight lines and complementary angles and beveling, which have no effect on performance, quality, competitiveness, or cost.¹⁰ *Fujita* 51:22-52:13; *Mieritz* 74:25-76:8. Although an engine with a front-mounted panel air cleaner is certainly one alternative,¹¹ Opposers ignore the numerous other alternative designs available in the market, which like the GX, are compact and offer the same performance benefits yet are nonetheless visually distinct (as exemplified in Opp. Br. at 24-25).

¹⁰ That the GX Trade Dress includes the specific styling of each component and how they together express an overall cubic look distinguishes this case from *In re Heatcon*, 116 U.S.P.Q.2d 1366 (T.T.A.B. 2015), upon which Opposers rely. *In re Heatcon* found that a trade dress directed to the arrangement of ports, switches, indicators, jacks, and controls on a portable composite repair system was functional because, among other reasons, alternative arrangements of these components did not work as well as the arrangement depicted in the applied-for mark. *Id.* at 1372. Unlike in *In re Heatcon*, the GX Trade Dress is not simply the arrangement of functional features, but rather the distinctive styling of each component, and how those components together express a distinct overall look.

¹¹ Engines with front-mounted panel air cleaners are competitive and have found success in the market. *Mieritz* 48:9-50:10 (explaining benefits of front-panel air cleaner):

[REDACTED] k
ines (that use a panel air cleaner).

As Opposers' own witnesses concede, even though an engine manufacturer may choose to utilize an engine with its components in the same general locations as the GX, they may nonetheless distinguish the overall aesthetic look of their engines. [REDACTED]

[REDACTED]

[REDACTED]

Further, many of the witnesses in this case (including Opposers') have described the differences between the GX Trade Dress and various third party designs. *Id.*

These numerous alternatives exist due to the many stylistic options possible for each component at issue. For example, numerous fuel tanks exist that vary in appearance from the GX's fuel tank in terms of seam placement, beveling, and angle of walls. *See* Mieritz 27:16-32:3 (describing differences in fuel tank shapes for the Kohler Command Pro 7 (App. Ex. 17), Intek 900 (App. Ex. 21), Vanguard 9hp (App. Ex. 24), and Kawasaki FE250 (App. Ex. 43)); Reisel 109:6-114:10 (agreeing that the GX fuel tank differs in appearance from the Kohler Command Pro 7 (App. Ex. 17), Intek 900 (App. Ex. 21), Subaru EX 35 (App. Ex. 22), Subaru EX 17 (App. Ex. 23), Vanguard 9hp (App. Ex. 24), Subaru SP 170 (App. Ex. 26), Briggs 750 (App. Ex. 27), Predator (App. Ex. 28), Lifan (App. Ex. 30), and Kawasaki FJ180 (App. Ex. 31)); [REDACTED]. Opposers have presented no evidence that any of these styling options in any way affects the performance, quality, cost, or competitiveness of the engines. *See* Mieritz 32:4-33:8 (testifying that these options do not affect these considerations). To the contrary, Opposers' witnesses admit that some of the alternatives may have advantages over the GX fuel tank. *See, e.g.,* Reisel 105:14-106:4, 108:4-8 (admitting that the fuel tank in both the Kawasaki FE250 and the Vanguard 9hp runs across the front top of the engine and that this configuration may actually provide a performance benefit).

As to the air cleaner, Dr. Reisel agreed that numerous competitors offer engines with top-mounted air cleaner covers that differ in appearance from the GX, and he offered no opinion as to whether such differences would affect performance, quality, or competitiveness. *See* Reisel 122:22-123:6, 124:8-126:12, 127:2-7 (addressing the Subaru EX17 (App. Ex. 23), Subaru SP 170 (App. Ex. 26),

Predator (App. Ex. 28), Champion (App. Ex. 29), Lifan (App. Ex. 30), and All Power (App. Ex. 32)). As Mr. Mieritz explained, “[t]he air cleaner cover . . . could take on a trapezoid shape, the edges could be angled. The top could be stepped. The top could be domed. It could be a cylindrical design. There’s many different shapes that you can take on.” Mieritz 50:11-51:2. Further, Dr. Reisel provided no opinions as to the comparative costs of such alternative designs.

Competitors also have many options for the shape of the carburetor cover and the placement of the controls. For example, the carburetor covers of the Kohler Command Pro 6 and 7 (App. Exs. 17, 44) both create a continuous slanted line from the left hand side of the engine towards the fan cover, the Subaru EX 17 (App. Ex. 23) is taller with sharp edges, and the Briggs Intek 900 (App. Ex. 21) does not even use a carburetor cover. Mieritz 60:6-63:2. Dr. Reisel agreed that “styling differences” exist with respect to the carburetor cover (Reisel 130:22-131:5), and further confirmed that “there are a variety of styling options available for the location of the controls.” *Id.* at 135:20-136:4; *see also id.* at 128:7-131:5 (admitting to differences in control placement on the Vanguard 9hp (App. Ex. 24), Briggs 750 Series (App. Ex. 27), Predator (App. Ex. 28), Kawasaki FJ180 (App. Ex. 31), and All Power (App. Ex. 32)); Mieritz 65:8-69:1 (discussing options as exemplified in App. Ex. 46).

As to the fan cover, Mr. Mieritz explained that many competitors’ fan covers have different shapes than the GX, as seen in the Briggs Intek 900 (App. Ex. 21), Kawasaki FE250 (App. Ex. 43), Subaru EX 17 (App. Ex. 23), and the Kohler Command Pro (App. Ex. 17). Mieritz 37:24-43:9; App. Ex. 45 (highlighting differences). Likewise, Dr. Reisel admitted, “there are differences that can be made with this fan cover, and many of these fan covers appear to be generally more rounded on the top and the side as opposed to being the straight edges presented in the trademark.” Reisel 103:24-104:9.

In sum, Opposers have presented no evidence that alternatives to the GX Trade Dress are unavailable. To the contrary, Dr. Reisel admitted that there were “a variety of styling options available” for each engine component (*id.* at 114:11-115:1, 127:2-7, 130:22-131:5, 135:20-136:11), and he was unaware of any differences in performance, manufacturing costs, or competitiveness between the GX and the alternative designs offered by others. *Id.* at 78:24-96:5. As Dr. Reisel admitted, an engine may have

rectangular components and still look different than the GX. *Id.* at 154:5-24. Opposers have therefore failed to establish that this factor supports a finding of functionality; in fact, the wealth of alternative designs confirms that the specific styling encompassed by the GX Trade Dress is not functional.

c) Honda's Advertisements Do Not Ascribe Any Utilitarian Benefits To The GX Trade Dress

Opposers argue that Honda “routinely touts the functional features of its GX in its advertising” such as reliability, durability, and compactness. Opp. Br. at 34-35. In a continuing theme, Opposers misapply the law and mischaracterize both the GX Trade Dress and Honda’s advertising.

In order to support a finding of functionality, the advertising at issue must tout utilitarian advantages “*of the design*” for which trademark protection is sought, not simply the benefits of the product generally. *In re Morton-Norwich*, 213 U.S.P.Q. at 15 (emphasis added). While it is certainly true that Honda’s advertising discusses the functional benefits of the GX, nowhere does that advertising ascribe any of those benefits to the specific “cubic” look comprising the GX Trade Dress. *See, e.g.*, App. Ex. 78 (attributing functional benefits like fuel efficiency, proven reliability, and easy starting to elements unrelated to the GX Trade Dress, such as the “OHV design”); [REDACTED] App. Exs. 79-83; Opp. Exs. 38-43. Because Honda’s advertisements do not to attribute any functional benefit to the GX Trade Dress, they support a finding that the GX Trade Dress is nonfunctional. *See Global Manufacture Grp. v. Gadget Universe.com*, 417 F. Supp. 2d 1161, 1169 (S.D. Cal. 2006) (finding non-functionality “supported because [the] advertisements do not tout the function of the design, but rather focus on the engineering advantages of the [product]”).

d) The GX Design Is Not Dictated By A Comparatively Simple Or Inexpensive Method Of Manufacture

Opposers assert in summary fashion that “the record contains no information” from which the Board could determine whether the GX Trade Dress is dictated by a comparatively simple or inexpensive method of manufacture, arguing that the testimony of Honda GX engineer Mr. Fujita and functionality expert Mr. Mieritz is conclusory and lacks foundation. Opp. Br. at 38. Opposers’ argument lacks merit.

First, Opposers have the burden of establishing a prima facie case of functionality, which they have not met because they have offered *no* evidence that the specific ornamental features of the GX Trade Dress are easy or inexpensive to manufacture.

Second, both Messrs. Fujita and Mieritz are well-qualified to testify regarding the costs of manufacture of the GX or comparable engines. [REDACTED]

[REDACTED] Mr. Fujita therefore had personal knowledge of the styling decisions made to express the styling group's goal of achieving a distinct cubic look for the GX and the impact that some of those decisions had on the cost to manufacture the GX. *Id.* at 15:23-16:13. In particular, Mr. Fujita explained that: (1) styling the bottom and left side of the fuel tank flatter to achieve the "cubic" look decreased fuel capacity and required Honda to use an overall larger fuel tank to compensate for this styling decision, thereby increasing material costs (*id.* at 31:14-32:8); (2) placing the seam of the fuel tank slightly below center in order to have it align with the belt-like area on the air cleaner cover required additional manufacturing steps than if the seam were at center¹² (*id.* at 32:9-33:11); (3) adding beveling (as opposed to simply a rounded edge) to the metal fuel tank in order to accentuate the straight lines involved extra steps, which increased costs (*id.*); (4) using a cube-shaped air cleaner cover (as opposed to one that is oval-shaped) resulted in increased material costs (*id.* at 38:3-20); and (4) using intersecting straight lines to form a square corner on the upper left portion of the fan cover negatively affected the air flow and required use of a larger cooling fan, thereby making the engine heavier and more costly to manufacture. *Id.* at 45:13-47:17, 87:15-88:11.

Mr. Mieritz worked as an engineer at Opposer Briggs for over forty years, where he gained extensive experience in designing "virtually every component within the engine" as well as designing (and redesigning) complete engines, including those that compete with the GXs. Mieritz 4:25-5:3, 7:14-9:17. In the design process, manufacturing costs were a primary issue, and he worked with a cost

¹² Briggs's trial witness, Mr. Whitmore, confirmed that placing the seam on the fuel tank at the center is the "ideal location for ease of manufacturing," and that "[a]ny deviation from have that seam in the center would create a more difficult part to manufacture." Whitmore 54:4-21.

estimator for each component of the engine to ensure he was meeting target specifications. *Id.* at 4:25-5:3, 9:18-10:10. Additionally, Mr. Mieritz became familiar with competitor engines, including the GX, through benchmark testing on competitors' engines and components. *Id.* at 10:11-11:1, 79:17-81:18. Mr. Mieritz is therefore well-qualified to offer opinions regarding the impact of particular design decisions on manufacturing costs, including his testimony that the specific cubic styling of each component of the GX was not driven by cost and that the alternative designs would not be any more costly to manufacture than the GX. *Id.* at 21:1-6, 25:8-11, 35:18-22, 44:23-45:5, 47:21-48:1, 57:4-11, 59:8-13, 63:9-14. Thus, Honda has offered substantial credible evidence that the distinct cubic styling of the GX Trade Dress is not dictated by a simple or inexpensive cost of manufacture, and Opposers have not presented any evidence to suggest otherwise, failing to meet their burden of proof.

In sum, Opposers have presented no evidence that the conscious styling features comprising the GX Trade Dress affect performance, quality, cost, or competitiveness and therefore have failed to carry their burden of establishing a prima facie case of functionality under the *Morton-Norwich* factors. In fact, each of these factors supports a finding of non-functionality when applied to the actual GX Trade Dress before the Board.

B. The GX Trade Dress Has Acquired Distinctiveness

During prosecution, Honda presented strong evidence that the GX Trade Dress has acquired distinctiveness (*see* Section V.E.2.), and the examiner found that Honda presented sufficient evidence to warrant publication of the applied-for mark. As a result, Opposers have “the initial burden to establish prima facie that the applicant did not satisfy the acquired distinctiveness requirement.” *As Holdings v. H&C Milcor*, 107 U.S.P.Q.2d 1829, 1837 (T.T.A.B. 2013). An opposer meets its initial burden only if it “produces sufficient evidence or argument whereby, on the entire record then before the board, the board could conclude that the applicant has not met its ultimate burden of showing acquired distinctiveness.” *Sheetz of Del., Inc. v. Doctors Assocs.*, 108 U.S.P.Q.2d 1341, 1367 (T.T.A.B. 2013).

“Secondary meaning can be sustained on purely circumstantial evidence.” *Tone Bros. Inc. v. Sysco Corp.*, 31 U.S.P.Q.2d 1321, 1330 (Fed. Cir. 1994). Relevant evidence includes, but is not limited

to: (1) exclusivity, length, and manner of use; (2) amount and manner of advertising; (3) amount of sales and number of customers; (4) place in the market; and (5) proof of intentional copying. *Gasser Chair Co. v. Infanti Chair Mfg. Corp.*, 47 U.S.P.Q.2d 1208, 1211 (Fed. Cir. 1998); *Al-Site Corp. v. VSI Int'l, Inc.*, 50 U.S.P.Q.2d 1161, 1173 (Fed. Cir. 1999); *Tone Bros.*, 31 U.S.P.Q.2d at 1329; 2 McCarthy on Trademarks and Unfair Competition § 15:30 (4th ed.).

Secondary meaning may also be shown through survey evidence. Survey evidence is not, however, required to establish that a trade dress has secondary meaning. *Tone Bros.*, 31 U.S.P.Q.2d at 1330 (denying summary judgment and finding in favor of plaintiff trade dress holder, where survey relied on by both parties had “reliability problems,” but where plaintiff offered strong circumstantial evidence); *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 25 U.S.P.Q.2d 1913, 1922-23 (Fed. Cir. 1993) (affirming finding of secondary meaning with evidence only of sales figures and six months of advertising).

As shown below, Opposers have presented no credible or relevant evidence that the GX Trade Dress lacks acquired distinctiveness, and thus have failed to meet their burden of proof. Further, Honda has presented compelling evidence of distinctiveness, which Opposers cannot refute.

1. Each Of The Secondary Meaning Factors Supports A Finding That The GX Trade Dress Has Acquired Distinctiveness

Honda’s exclusive use of the GX Trade Dress for more than three decades, its extensive sales and advertising of the GX, its well-established place in the market, and the widespread and intentional copying of the GX by its competitors, constitute strong circumstantial evidence that the GX Trade Dress has secondary meaning. As shown below, Opposers cannot meaningfully refute this evidence, and therefore cannot meet their burden of proof.

a) Exclusivity, Length, And Manner Of Use

Honda’s exclusivity, length, and manner of using the GX Trade Dress is persuasive evidence that the trade dress has achieved secondary meaning. *See The George Basch Co. v. Blue Coral Inc.*, 23 U.S.P.Q.2d 1351, 1355 (2d Cir. 1992) (holding that exclusive use since 1983 was sufficient to uphold finding of secondary meaning). [REDACTED]

[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED] App. Exs.
67-69.

Opposers do not (and cannot) refute this strong evidence of Honda's continuous and exclusive use of the GX Trade Dress. Again reflecting their mischaracterization of the applied-for mark, Opposers instead argue that Honda does not have exclusive use of GX Trade Dress, because certain third-party engines have components in roughly the same locations as the GX Trade Dress. Opp. Br. at 39-40. As explained above, Honda does not seek a trade dress covering all engines with the same general configuration. Rather, Honda claims only the *specific, overall cubic look depicted in the Application*. (See Section V.A., *supra*, for a full discussion of the mark's scope.)

Opposers admit that these third party engines differ in appearance from the GX Trade Dress, but argue that these differences are insignificant. Opp. Br. at 40. However, photographs of these third party engines reveal that the overall look of each engine is distinct from the GX Trade Dress. *See, e.g.*, App. Exs. 17, 19 (Kohler); 20, 25, 31 (Kawasaki); 21, 24, 27 (Briggs); 22-23, 26 (Subaru)¹³; 28 (Predator); 29 (Champion); 30 (Lifan); 32 (All Power); 104 (BlueMax); 105 (Generac). In fact, Opposers' own witnesses identified many of these differences in their testimony. *See, supra*, Section V.F. [REDACTED]
[REDACTED]

¹³ Opposers' unsupported assertion that Subaru "sells nearly 10 different engines with substantially similar shapes and configuration to the applied-for mark" is misleading and unavailing. Subaru sells horizontal shaft engines within two families, the "EX brand" family and the "SP brand" family. Opp. Ex. HH at HH-2 ¶¶ 3, 7. Much like the GX, Subaru engines are available in different sizes within each of the two brand families. *See* Opp. Ex. HH at HH-19, 21, 23, 25, 27, 29, 31, and 33 (images of Subaru engines). Dr. Reisel and Mr. Conner testified in agreement that engines within each of these two brand families differ in appearance from the Honda GX. Reisel 101:14-102:2, 102:12-103:15, 111:17-113:4, 113:20-114:5, 122:13-123:6, 124:8-13, 128:20-129:2; [REDACTED]

[REDACTED]

[REDACTED] Thus, Opposers have not met their burden and failed to rebut Honda's strong evidence of its continuous and exclusive use of the GX Trade Dress.

b) Amount And Manner Of Advertising

Honda's advertising activities strongly support a finding that the GX Trade Dress has achieved secondary meaning. *See George Basch*, 23 U.S.P.Q.2d at 1354-55 (\$75,000 in advertising expenditures supported finding of secondary meaning). [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] This "hero shot" has consistently appeared in Honda's print advertisements over at least the past 15 years. *See, e.g.*, App. Exs. 78-83; Opp. Exs. 32, 38-43. Similarly, other promotional materials, such as Honda and OEM product brochures, have featured the GX Trade Dress – including in colors other than red, white and black – since at least 1985. [REDACTED] *See also, e.g.*, App. Exs. 68-69, 71-72.

Opposers argue that Honda's advertising is not relevant because: (1) it is not so-called "look for" advertising; (2) it relies on Honda's red, white, and black color scheme; (3) it promotes the Honda name; and 4) it touts functional features of the GX. Each of these arguments fails.

First, neither the Federal Circuit nor the Board has required "look for" advertising to establish secondary meaning. *See Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 6 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1988) (affirming the Board's determination that "although the [applied-for trade dress] was not the sole or primary focus of the advertising . . . the constant promotional display of the product pictures did contribute to the recognition of the [trade dress] designs as source indicators."); *In re Black & Decker*

¹⁴ [REDACTED]

Corp., 81 U.S.P.Q.2d 1841, 1842, 1844 (T.T.A.B. 2006) (holding that trade dress had secondary meaning where “applicant spent more than \$20 million on advertising and marketing products identified by the Baldwin Key Head Design mark, and during the same period earned over \$500 million in sales revenues” but lacked “‘look for’ advertising or promotion of the octagonal key head design”).¹⁵

Furthermore, Honda’s use of the “hero shot” is tantamount to “look for” advertising. “Look-for” advertisements are considered valuable evidence of secondary meaning because they “demonstrate the promotion and recognition of the specific configuration embodied in the applied-for mark.” *AS Holdings*, 107 U.S.P.Q.2d at 1838. [REDACTED]

[REDACTED]

[REDACTED]

Second, with respect to color, Opposers’ argument ignores that [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]; *see also*, e.g., App.

Exs. 72-75 (examples of GXs in black, yellow, and blue). Furthermore, some of Honda’s advertising has relied on consumers’ association of the appearance of the GX with Honda without color. For example,

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

¹⁵ In the cases cited by Opposers, the absence of “look for” advertising was only one of many factors the Board considered in finding a lack of secondary meaning. *See, e.g., Stuart Spector Designs Ltd. v. Fender Muscial Instr. Corp.*, 94 U.S.P.Q.2d 1549, 1574 (T.T.A.B. 2009). Here, the overwhelming evidence demonstrates that Honda has established secondary meaning through long-term continuous exclusive use of the GX Trade Dress, extensive sales and advertising of the GX, an established place in the market, widespread intentional copying of the GX, and corroborating survey evidence.

¹⁶ Opposers’ discussion of “[c]onsumer association of the ME’s red and white color scheme with Honda” is misleading and irrelevant. Opp. Br. at 41. *First*, any consumer recognition of the red and white color scheme mentioned in Fujita Ex. 189-A specifically referred to consumer association *outside* the United States. *Second*, the article referred to a two-color scheme on an engine with a completely different external appearance. Whether consumers associated the external appearance of this engine with Honda is irrelevant to this proceeding. Similarly, Opposers’ reliance on irrelevant and inadmissible evidence from foreign trademark proceedings is improper. Appendix A details Honda’s objections to this evidence.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Therefore, there is ample evidence that Honda, either directly or indirectly, markets the GX Trade Dress in a wide variety of color schemes, such that it has acquired secondary meaning in the minds of consumers, wholly independent of color.

Third, Opposers’ argument that Honda’s advertising promotes “Honda” rather than the GX Trade Dress is unavailing. There is no evidence that customers associate the GX Trade Dress with Honda based on anything other than the engine’s look. [REDACTED] Honda advertisements that feature both the “hero shot” and the word “Honda” serve only to strengthen consumers’ association of the GX Trade Dress with its source, Honda. *Id.*; *see also, e.g.*, App. Exs. 78 (the most prominent feature is Honda’s “hero shot,” pictured within the outline of a human head, with the tagline, “It’s the first thing a good foreman thinks of,” and a small “Honda Engines” logo at the bottom of the page); 80 (features the “hero shot” covering most of a map of the United States, with the tagline “One Engine for All” and the “Honda Engines” logo at the bottom of the page).

Finally, Opposers claim that Honda’s advertising touts purportedly functional advantages of the GX Trade Dress. Opp. Br. at 43. Opposers rehash their same arguments for functionality here, and those arguments fail for the same reason: Honda’s advertising does not ascribe any functional benefits to the specific “cubic” styling comprising the GX Trade Dress.¹⁷ *See* Section VI.A.2.c.

c) Amount Of Sales And Number Of Customers

The amount of sales and number of customers for the GX are additional strong evidence that the GX Trade Dress has secondary meaning. *See George Basch*, 23 U.S.P.Q.2d at 1355 (holding that \$7 million in sales was sufficient to uphold finding of secondary meaning). [REDACTED]

¹⁷ [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] In arguing that the GX Trade Dress lacks secondary meaning, Opposers fail even to address this evidence.

d) Established Place In The Market

The GX's market share and industry recognition further support a finding of secondary meaning. As detailed in Section V.C. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Also, Mr. Mieritz – a former Briggs engineer with over 40 years of experience, who designed engines that competed with the GX – testified that based on his experience working with OEMs, distributors, and dealers, he came to understand that Honda was viewed as the #1 engine in the industry, and that the look of the GX was known throughout the industry. Mieritz 96:12-98:25, 220:5-16, 220:25-221:15. This is further supported by the signed statements of 16 distributors of Honda GXs, submitted during prosecution, who attested that the GX Trade Dress is “well known and famous in the construction and power equipment industry as being the engine appearance and shape of engines sold by Honda” and that they distribute the GX because it is “recognized by our customers as a superior quality engine produced by Honda.” Exhibit to June 11, 2007 Resp. to O.A. It is not surprising then, that the GX – alone or incorporated into power equipment – has received numerous awards from industry groups and trade publications. *See, supra*, Section V.C.

Faced with this compelling evidence, Opposers argue that Honda has “diluted” consumer association of the GX Trade Dress with Honda by permitting OEMs to place their labels on GXs that are incorporated in their power equipment. Opp. Br. at 43-44. This argument actually cuts against Opposers’

assertion that the GX Trade Dress lacks secondary meaning because it assumes that consumers recognize the GX Trade Dress and associate it with Honda – otherwise the OEM label would be unnecessary. In fact, [REDACTED]

[REDACTED] The OEM labels are designed to prevent confusion and strengthen consumer association of the *power equipment product* with the OEM, rather than reduce consumer association of the *GX Trade Dress* with Honda.

Moreover, Opposers have failed to demonstrate that such conduct constitutes “resale to the consuming public as the products of those third parties.” Opp. Br. at 44 (quoting *British Seagull Ltd. v. Brunswick Corp.*, 28 U.S.P.Q.2d 1197, 1203 (T.T.A.B. 1993)). Opposers offer no evidence that the OEM products in question fail to identify their GXs as originating from Honda. [REDACTED]; Opp. Exs. 33-35. [REDACTED]

[REDACTED]. Such “co-branding” of a product does not constitute dilution. See *In re Polar Music Int’l AB*, 221 U.S.P.Q. 315, 318 n.3 (Fed. Cir. 1983) (“The marks of different entities may, of course, appear on a single product where they serve separate functions; for example, manufacturer/distributor, ingredient/product, licensor/licensee.”); 1 McCarthy on Trademarks and Unfair Competition § 7:8 (4th ed.).

e) Proof Of Intentional Copying

“Evidence of deliberate copying is relevant to a determination of secondary meaning. Indeed, in appropriate circumstances, deliberate copying may suffice to support an inference of secondary meaning.” *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 58 U.S.P.Q.2d 1881, 1888 (9th Cir. 2001). Honda has presented evidence of widespread, intentional copying of the Honda GX, which Opposers do not contest.

As detailed in Section V, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]. Honda succeeded in obtaining an injunction against some of these engines. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Thus, this widespread, intentional copying of the GX is strong evidence that the GX Trade Dress has secondary meaning. Opposers' Brief ignores this evidence.

2. Survey Evidence Further Corroborates That The GX Trade Dress Has Secondary Meaning

Beyond this strong circumstantial evidence that the GX Trade Dress has acquired secondary meaning, the results of Honda's secondary meaning survey show that a substantial proportion of the relevant population, 42.4%, associates the GX Trade Dress with Honda, which further corroborates that the GX Trade Dress has achieved secondary meaning. *See, e.g., Thomas & Betts Corp. v. Panduit Corp.*, 46 U.S.P.Q.2d 1026, 1040 (7th Cir. 1998) (stating that association of 30% is "probative of the issue of secondary meaning, and the factfinder should weigh that fact with all of the other evidence to determine if secondary meaning exists"); *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 217 U.S.P.Q. 988, 998 (5th

Cir. 1983) (finding secondary meaning where 23% and 28% of respondents in two surveys produced the name of the product at issue when presented with a description of it); *Yankee Spirits, Inc. v. Gasbarro*, 1998 WL 428092, at *10 (D. Mass. May 26, 1998) (holding that recognition of 29% was “far from fatal” to a finding of secondary meaning).

As discussed more fully below, every element of Mr. Mantis’ survey was designed and conducted under well-accepted survey protocols to ensure objectivity and reliability, including that: (1) the sample was representative of the relevant universe; (2) an appropriate control was used to accurately assess survey noise; (3) the survey design properly addressed its objective, namely to determine whether the applied-for mark has secondary meaning; (4) the survey questions were framed clearly and precisely to avoid bias and order or context effects; and (5) the data was accurately analyzed and reported. This is in contrast to Mr. Poret’s survey, where he failed to adhere to each of these standard survey protocols, thereby rendering his survey results unreliable and irrelevant.

a) The Mantis Survey Is Reliable And Demonstrates That The GX Trade Dress Has Secondary Meaning

Honda’s survey expert, George Mantis, has over four decades of experience designing, conducting and reporting on surveys, including in the area of trademark and trade dress. Mantis 6:8-8:2. He has been accepted as an expert on trademark surveys in numerous federal courts, the T.T.A.B., and the Copyright Office since 1985, and has lectured on the use of survey research in trademark matters at numerous conferences, bar associations, forums, and at John Marshall Law School. *Id.* at 8:3-10:3; App. Ex. 53.

The universe for Mr. Mantis’ survey consisted of purchasers of the types of engines at issue, and purchasers/renters of products containing such engines, namely: Equipment Purchasers/Renters, Rental Yards, OEMs, Retail Trade and Wholesale Trade. Mantis 12:22-13:25. He then identified the relevant standard industrial classification (“SIC”) codes to identify actual businesses to contact. *Id.* at 14:1-25; 16:2-17:2. Mr. Mantis hired an interviewing firm to conduct the interviews (*id.* at 17:22-18:1), and an independent interviewing specialist to train the interviewers. *Id.* at 21:11-23:10; App. Ex. 57 (interviewer

instructions). The interviewing firm contacted the businesses that fell within the universe by phone (Mantis 17:3-21) and screened them to make sure they were qualified to take the survey (*id.* at 18:13-19:21; App. Ex. 55 (screening questionnaire)). The resulting sample composition of those who qualified and took the survey fairly represents the universe of potential customers of the engine at issue. Mantis 19:22-21:5; App. Exs. 56 (summary of sample composition with proportion of respondents for each type of organization; 54 (summary of sample composition based on SIC codes)).

Mr. Mantis then randomly placed qualified respondents into one of two groups: a test group, or a control group. Mantis 23:23-24:15. Test group respondents were shown a black-and-white digitally altered (to remove names, model numbers, and other indicia of origin) photo of a Honda GX (“Test Image”) (App. Ex. 59); control group respondents were shown a black-and-white digitally altered photo of a Briggs Intek engine (“Control Image”) (App. Ex. 60). Mantis 24:16-26:5. Black-and-white photos were shown because color is not claimed as part of the applied-for mark. *Id.* at 25:6-9.

To determine the true level of association of the applied-for mark with the relevant population, it is necessary to assess the level of survey noise (that is, the percentage of respondents that identify the GX Test Image with Honda for reasons unrelated to the applied-for mark, such as guessing). *Id.* at 26:6-27:4. The primary method of estimating survey noise is to use a control. *Id.* at 27:5-9. Here, the Briggs engine was chosen as the Control Image because it does not contain either the individual ornamental features or the overall cubic look of the applied-for mark. *Id.* at 28:1-29:1.

Interviewers asked the qualified respondents a series of questions regarding the Test or Control Image to determine whether the respondent associated the engine shown with a particular company or companies, and if so, which ones, and why.¹⁹ Mantis 23:14-22, 29:13-35:14; App. Ex. 58 (survey questionnaire). The interviewers recorded the responses to the questions verbatim to allow assessment of

¹⁹ The survey questionnaire utilized “probing questions” to gain insight into the reasons for association with the identified source(s) (*i.e.*, “what makes you associate this engine with [identified source(s)]?” followed by “what do you mean by that?” followed by “anything else?” followed by “what do you mean by that?”). App. Ex. 58. Because the purpose of the survey was to test whether the relevant population associates the GX Trade Dress with Honda, it was necessary to determine why respondents associated the Test Image with Honda to ensure it was not due to some reason other than the applied-for mark. Oddly, Mr. Poret also used similar probing questions and required that the responses be recorded verbatim, but did not rely on them when categorizing the responses. Poret 34:2-36:4, 89:13-25.

objective data (rather than an interpretation of what the respondent said). Mantis 35:15-36:9. The survey was conducted under double-blind conditions. *Id.* at 36:10-37:7. After all the interviews were completed, a company independent of the Mantis Group and the interviewing company, validated the survey by re-contacting a portion of the respondents to confirm that they in fact were interviewed. *Id.* at 37:8-39:20; App. Ex. 61 (validation questionnaire and report).

Once the survey was complete, Mr. Mantis reviewed and analyzed the responses. Mantis 39:21-42:17; App. Ex. 62 (tables summarizing responses). The Test Image yielded 51.3% association with Honda, while the Control Image yielded 8.9% association with Honda. Mantis 42:18-45:1. Mr. Mantis then subtracted the percentage of respondents who associated the Control Image with Honda from the percentage of respondents who associated the Test Image with Honda to arrive at an estimate of association free from survey noise. *Id.* at 45:2-22. This calculation yielded a net association of 42.4%. *Id.* at 45:23-46:25; App. Ex. 63 (summary of findings). The results of Mr. Mantis' secondary meaning survey show that a substantial proportion of the relevant population associates the GX Trade Dress with Honda, which further corroborates that the trade dress has achieved secondary meaning. Mantis 11:3-12:1, 47:1-11.

b) Opposers' Criticisms of Mantis' Survey Are Meritless

Opposers make a number of criticisms of Mr. Mantis' survey, each of which is without merit.

First, Opposers argue that Mr. Mantis failed to control for color in his survey because he showed three tones in the Test Image and two tones in the Control Image. Opp. Br. at 47-48. Opposers' survey expert, Mr. Poret, purposely injected color into his survey, whereas Mr. Mantis used black-and-white photos of the Test and Control Images in order to avoid having color be an issue.²⁰ In addition, Mr. Mantis further controlled for color in both his Test and Control Images by analyzing the verbatim responses and excluding those responses that only mention color as the basis for association with Honda.

²⁰ Opposers also argue that Mr. Mantis' Control Image improperly shows a silver muffler. Opp. Br. at 48 n.9. As Mr. Mantis explained, the test and control images do not need to display the exact same design features so long as the control serves the function of assessing survey noise. Mantis 49:21-51:8. As discussed above, Mr. Mantis carefully selected the Briggs engine as the control because it did not contain either the individual ornamental features or the overall cubic look of the applied-for mark.

Mantis 43:2-12, 49:4-20, 160:22-161:4. As the verbatim responses show, the three tone image of the test engine and the two tone image of the control engine did not affect the proportion of Honda single-source mentions for trade dress-related reasons: with the exception of 3 responses, all others gave a trade dress-related reason for their association with Honda (that is, they identified specific ornamental features of the engine and/or the overall look).²¹ *Id.* at 47:12-49:3, 127:24-128:6.

Second, Opposers argue that Mr. Mantis improperly counted certain “more than one company responses” toward secondary meaning, namely those that identified the Test Image with both Honda and a copy engine manufacturer.²² Opp. Br. at 50. As both Messrs. Mantis and Poret agree, the purpose of the survey is to determine whether the applied-for mark is associated with a *single source*. Because the other source is a copy manufacturer, respondents are implicitly associating the mark with Honda. Mantis 44:4-17.

Third, Opposers argue that Mr. Mantis improperly showed certain labels that appear on the Test and Control Images, such as the speed control labels. Opp. Br. at 50. However, Mr. Mantis included these labels because they are not indicators of source (in contrast to a brand name or model number), are standard throughout the industry, and present the product appropriately. Mantis 52:10-53:10; Mieritz 69:2-20. Furthermore, these labels had no effect on the survey results because the few respondents that mentioned labels also gave a trade dress-related reason for their association with Honda. Mantis 53:11-18.

Finally, Opposers argue that Mr. Mantis improperly asked respondents whether they associate the *engine*, rather than the *appearance of the engine*, with one (or more) companies. Opp. Br. at 50. But in fact, Mr. Mantis took a conservative approach by not referring to the appearance of the engine in the questions to avoid the possibility that respondents would focus on the appearance of the engine and to avoid suggesting that a single-source response was required. Mantis 31:10-20, 122:12-123:4.

²¹ In the alternative, Opposers argue that Mr. Mantis did not correctly analyze the verbatim responses. Opp. Br. at 49. Specifically, Opposers argue that it was improper for Mr. Mantis to count towards secondary meaning those responses that indicated association with Honda based on: (1) color and design; (2) “appearance” of the engine; and (3) the fuel tank, because it is *possible* that color was the cause of the association. *Id.* However, as the verbatim responses *actually* show, all of these responses identified a trade dress-related reason for the association. Mantis 43:13-44:3.

²² It is irrelevant whether Honda deems the identified knock-off engines as unacceptable copies or acceptable non-infringing designs. As Mr. Mantis explained, this inquiry is relevant for likelihood of confusion, and not secondary meaning. Mantis 119:21-121:8.

c) The Poret Surveys Are Unreliable And Irrelevant Because They Did Not Test For Secondary Meaning In The Applied-For Mark And Did Not Adhere To Standard Survey Protocols

Opposers seek to disregard the Mr. Mantis' survey and instead point to the two surveys that their expert, Hal Poret, conducted, purporting to show that 9.7% or 18.1% of respondents associate the GX Trade Dress with Honda. However, Mr. Poret's surveys contain several fatal flaws that render them unreliable and irrelevant under standard, well-accepted survey protocols. *See App. Exs. Q, R (Reference Guide on Survey Research)*, 108 at 6; Poret II 80:6-25 (agreeing that certain criteria in the *Reference Guide on Survey Research* are generally employed in the field of survey research).

First, despite purportedly designing and conducting a survey to test whether the GX Trade Dress has secondary meaning, at his trial deposition, Mr. Poret confirmed that he did *not* understand (or even attempt to understand) the scope of the applied-for mark. Poret II 74:3-78:2 (testifying that he did not understand several of the ornamental features or the "overall cubic" design identified in the description of the mark). For example, without knowing the scope of the mark in question, Mr. Poret could not possibly determine whether his Control Image properly served the function of assessing survey noise. Therefore, this failing calls into question the overall reliability of his survey.

Second, in one survey, Mr. Poret improperly injected color as a consideration by using an image of a red-white-black GX and a digitally altered image of a Subaru Robin EX 21 engine to give it the same red-white-black color scheme.²³ Poret 94:25-95:12. It is undisputed that color is *not* part of the GX Trade Dress. *See App. Ex. 6*. As Opposers' own cited cases show (*see Opp. Br.* at 48), introduction of irrelevant matter – such as color – destroys any probative value of the survey. *See also* Poret II 28:2-13, 79:3-11; Mantis 66:17-69:7, 74:19-75:3. Indeed, Mr. Poret acknowledged that "it was appropriate to test respondents' perception of the engine *without* color so that color did not influence the results." Poret II

²³ Subaru Robin engines in a red-white-black color scheme do *not* exist in the marketplace. Poret 95:13-95:17.

89:21-90:5. Thus, his net association finding of 9.7% from his color survey should be disregarded entirely.²⁴

Third, in another survey, Mr. Poret took color out of the equation by using black-and-white images, but committed an equally serious error by using an inappropriate control.²⁵ Although Mr. Poret admitted that the control engine “should not be so overall similar in impression that it could be said to embody the mark” (Poret 84:15-85:2), he used as a control a Subaru Robin which Opposers have asserted “contain[s] virtually all of the same elements as the claimed Mark.” App. Ex. 109 at 5; *see also* App. Exs. 110 at 6 (claiming the Subaru Robin EX 21 “look[s] very much like” Honda’s claimed mark); 111 at 1 (including the Subaru Robin engines as having the “same or substantially similar . . . commercial impression” as the GX); Opp. Br. at 25 (identifying the Subaru Robin EX 21 as “substantially similar” to the GX). Mr. Poret acknowledged that he did not consider these documents when he selected his control and was not aware of Opposers’ position with respect to the similarities of the Subaru Robin and the GX Trade Dress at the time he submitted his report. Poret 83:3-84:6, Poret II 86:20-89:20; *Cf.* Poret II 97:6-98:19 (where Mr. Poret *now* claims that he understood Opposers’ position was that the Subaru Robin is substantially similar in terms of the major components and how they are laid out).

Mr. Poret attempts to justify the selection of his control by relying on Honda’s assertion that the Subaru Robin does not embody the applied-for mark.²⁶ Poret 32:8-19. However, clearly, Mr. Poret’s own clients – competitors of Honda – disagree. If there is any real dispute as to whether an engine is the same or substantially similar to applied-for mark, that engine is an inappropriate choice for a control because any “association” responses with this engine may be the result of noise or actual association or a combination of both – there is no way to tell. Mantis 63:25-66:7. Thus, Mr. Poret’s use of an invalid

²⁴The verbatim responses from Mr. Poret’s color survey do not in any event support his conclusion that 9.7% associated the applied-for mark with Honda: 66 out of 74 test group respondents gave a trade dress-related reason for their association with Honda. Mantis 69:12-71:11; App. Exs. 64 (verbatim responses mentioning Honda for both the test and control groups in Poret’s color survey); 65 (summary of App. Ex. 64).

²⁵Mr. Poret used the same control in his “color survey,” providing an additional reason why that survey is flawed and should be disregarded.

²⁶As Mr. Mantis explained, there are many factors that go into whether a third party use is deemed infringing or non-infringing, many of which are economic factors that are unrelated to the purpose of the secondary meaning study. Mantis 171:6-172:8.

control is a fundamental failing that, standing alone, renders Mr. Poret's findings of 9.7% and 18.1% association unreliable. *Id.* at 66:8-16.

Fourth, Mr. Poret's survey findings are unreliable because there is no basis from which to determine whether his sample is representative of the relevant universe. App. Ex. 108 (standard survey protocols require that "[a] representative sample be drawn from the relevant universe."). Unlike Mr. Mantis, Mr. Poret did not provide as part of his expert report or testimony the necessary information to make this determination.²⁷ Mantis 56:21-24. Instead, Mr. Poret points to a "sample disposition report" that he failed to include in his expert report and never even analyzed to confirm that his sample was representative. Poret 67:10-68:1. In fact, the data suggests that some segments of potential purchasers were under-sampled and others were over-sampled: Mr. Mantis' survey (whose sample Opposers have not challenged) had more than three times the proportion of equipment purchasers/renters than Mr. Poret, and less than five times the proportion of OEMs than Mr. Poret. Mantis 57:25-59:8 (comparing App. Ex. 56 with Opp. Ex. 65). Mr. Poret confirmed that over and under-sampling a particular segment could affect his survey results, and without having analyzed the "sample disposition report," he expected the percentages in each segment from his and Mr. Mantis' survey to be reasonably close. Poret II 82:19-85:13. In fact, this appears not to be the case, a flaw that further undermines the reliability of Mr. Poret's survey.

Fifth, Mr. Poret introduced systematic bias into his survey by improperly instructing the respondents that the image of the control engine (Subaru Robin EX 21) was an overhead *valve* engine, when in fact it is an overhead *cam* engine. Mantis 59:9-60:23. Mr. Poret confirmed that survey instructions and questions should be non-suggestive. Poret 87:15-21; Poret II 79:12-17. He also confirmed that it would have been an option not to mention "overhead valve" in his descriptions of the control and test images. Poret 88:16-23. By *misidentifying* the product shown as an overhead *valve* engine, Mr. Poret may have led respondents to consider only manufacturers of overhead valve engines

²⁷ Unlike Mr. Mantis, Mr. Poret did not provide the number of interviews *purchased* by each market segment and qualification rates for each segment by *SIC codes*. Mantis 56:21-57:24.

(like Honda), Mantis 59:9-60:23. [REDACTED]

[REDACTED] This potential bias could have artificially inflated Honda single-source responses in the control group, thereby deflating the net secondary meaning percentage.²⁸ Mantis 60:14-23.

Sixth, Mr. Poret also introduced potential bias into his survey by not rotating the answer choices “one company” and “more than one company” for the main secondary meaning question. Poret 89:8-12. As both Messrs. Poret and Mantis agree, it is standard practice to rotate these answer choices to avoid order bias – the phenomenon where the respondent is directed to the first option he hears. Mantis 61:21-63:2; App. Ex. 108 (standard survey protocols require “[t]he survey questions be framed clearly, precisely, and so as to avoid bias; and, as far as possible, so as to avoid order or context effect.”). In fact, Mr. Poret acknowledged that in prior surveys he rotated answer choices. Poret II 85:14-86:2.²⁹

Finally, survey execution errors and omissions call into question the overall objectivity and trustworthiness of Mr. Poret’s survey findings. For example, it appears from the verbatim responses that his instruction to record verbatim was not followed by the interviewers (Mantis 75:4-18), and unlike Mr. Mantis, Mr. Poret failed to *independently* validate his survey results (Poret 92:18-93:16; Poret II 81:1-13), as required by standard survey protocols to ensure the data is credible. Mantis 75:19-77:13.

3. Conclusion

Honda has presented compelling circumstantial evidence, much of it undisputed, and corroborating survey evidence showing that more than 42% of respondents in the relevant universe associate the GX Trade Dress with Honda. Courts have found secondary meaning established based on far less evidence than that presented here. *See, e.g., L.A. Gear*, 25 U.S.P.Q.2d at 1922-23 (affirming finding

²⁸ Mr. Poret argues that to the extent that Honda responses were inflated in the control group, they also were inflated in the test group because the same instruction was given. Poret II 49:18-50:1. However, as Mr. Mantis explained, this instruction is proper in the test group because it places the test image in the proper context based on an *accurate* identification of the engine, and thus could not have artificially inflated the level of association in the test group. Mantis 60:24-61:20, 174:19-176:2.

²⁹ Reading the same question to both the test and control groups did not prevent bias from being introduced, because it is not possible to determine whether respondents in one of the groups were affected more than in the other group. Mantis 63:3-24, 176:3-177:21.

of secondary meaning with no survey evidence and circumstantial evidence consisting only of sales figures and six months of advertising); *Yamaha*, 6 U.S.P.Q.2d at 1010 (affirming Board’s finding of secondary meaning where the applied-for trade dress was “not the sole or primary focus of the advertising,” and even though the applicant offered no survey evidence). There can be little doubt based on the record before the Board that the GX Trade Dress has achieved secondary meaning among consumers in the relevant market, and therefore that it has acquired distinctiveness.

C. The GX Trade Dress Is Not Generic

Opposers’ claim that the GX Trade Dress is generic largely repeats their argument regarding purported third-party use of the GX Trade Dress based on their mischaracterization of the applied-for mark. Opp. Br. at 51. As discussed in Sections V.F. and VI.A.2.b. above, the engines on which Opposers rely do not substantially embody the GX Trade Dress because, although they share the same basic layout as the GX, they do not reflect the unique and distinctive styling features that combined result in the overall “cubic” look that Honda seeks to protect through its Application. Even Opposers’ own expert witness was able to distinguish these third party engines from the GX based only on their external appearance, and Honda has never observed consumer confusion between these engines and the GX. *See, supra*, Section VI.B.2.a. Therefore, these third-party engines do not render the GX Trade Dress generic such that it no longer “continue[s] to indicate [its] source.” *Hermes Int’l v. Lederer de Paris Fifth Ave., Inc.*, 55 U.S.P.Q.2d 1360, 1365 (2d Cir. 2000).

To the extent that *other* third party engines embodying the GX Trade Dress continue to exist in the market, however, a party need not enforce its trade dress against every potential infringer in order to defend against assertions that the trade dress has become generic. *Bridgestone/Firestone N. Am. Tire, LLC v. Silverstone Behad*, 2003 WL 1559659, at *11 (T.T.A.B. Mar. 21, 2003) (“[I]n order to maintain enforceable trademark rights, one is not required to challenge every conceivable arguably similar mark in the marketplace.”); *Engineered Mechanical Servs. v. Applied Mechanical Tech., Inc.*, 223 U.S.P.Q. 324, 332 (M.D. La. 1984). As discussed above in Sections V.D. and VI.B.2.e., Honda’s enforcement efforts have been (and continue to be) diligent and extensive.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] and therefore it cannot support Opposers’ assertion that “widespread use has led to the applied-for mark becoming generic.” Opp. Br. at 51.

Far from showing that the GX Trade Dress has become generic, the settlement agreements demonstrate that Honda has vigorously enforced its trade dress against true copy engines, while recognizing that, contrary to Opposers’ assertions, its trade dress does not encompass all engines with the same general configuration as the GX. The purpose of barring registration of generic marks is to prevent a “monopoly on designs regarded by the public as the basic form of a particular item.” *Stuart Spector*, 94 U.S.P.Q.2d at 1555. Opposers have provided no evidence that Honda wields its trade dress as an anti-competitive cudgel. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

D. Honda Has Not Abandoned The GX Trade Dress

[REDACTED]

[REDACTED]

³⁰ [REDACTED] and [REDACTED] e Dress because, although they share the same basic layout, they do not reflect the numerous aesthetic styling features that contribute to the overall “cubic” look of the GX Trade Dress.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]; App. Ex. 83.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] App. Ex. 83.

1. Opposers Fail To Offer Prima Facie Evidence Of Abandonment

“[S]ince abandonment is in the nature of a complete forfeiture, it carries a strict burden of proof.” *Woodstock’s Enters. (Cal.) v. Woodstock’s Enters. (Or.)*, 43 U.S.P.Q.2d 1440, 1446 (T.T.A.B. 1997). A trade dress is abandoned only “when its use has been discontinued with intent not to resume such use.” 15 U.S.C. § 1127. “Nonuse for 3 consecutive years shall be prima facie evidence of abandonment.” *Id.* Opposers have failed to present prima facie evidence of abandonment because they cannot demonstrate that Honda has discontinued use of the GX Trade Dress currently or for the three prior consecutive years.

[REDACTED]

[REDACTED]

[REDACTED]

³¹ Honda can sell existing inventory without violating EPA regulations. *See* 40 C.F.R § 1068.101(a)(1)(i) (EPA compliance is tied to an engine’s model year); [REDACTED]

[REDACTED].³² Although fewer Tier II engines remain in Honda's inventory today than in 2012-2014, (App. Ex. 88; Opp. Exs. 51-53), "[t]here is also no rule of law that the owner of a trademark must reach a particular level of success, measured either by the size of the market or by its own level of sales, to avoid abandoning a mark." *Pers.'s Co. v. Christman*, 14 U.S.P.Q.2d 1477, 1481 (Fed. Cir. 1990); accord *The Wallpaper Mfrs. v. Crown Wallcovering Corp.*, 214 U.S.P.Q. 327, 330-31 (C.C.P.A. 1982). Finally, Opposers have offered no evidence to rebut Mr. Conner's testimony that

[REDACTED]. Because Opposers cannot demonstrate that Honda discontinued use of the Tier II engines, they cannot demonstrate that Honda has abandoned the GX Trade Dress.



Similarly, Opposers have failed to prove the second prong of abandonment: "intent not to resume use." 15 U.S.C. § 1127. [REDACTED]

[REDACTED] Further, intent is irrelevant to abandonment if a mark is still in use: "[A] prospective declaration of intent to cease use in the future, made during a period of legitimate trademark use, does not meet the intent not to resume standard." *Electro Source, LLC v. Brandess-Kalt-Aetna Grp.*, 80 U.S.P.Q.2d 1161, 1165 (9th Cir. 2006).

2. The Tier III Engine Maintains The Same Commercial Impression As Its Predecessor

Furthermore, Honda has not abandoned the GX Trade Dress because the Tier III engine continues to embody the applied-for mark. Modernization of a trade dress that retains the commercial impression of

³² Opposers have provided nothing more than attorney argument to rebut Mr. Conner's testimony [REDACTED] Op [REDACTED] t

the previous version may be tacked onto the previous version, and does not result in any abandonment or loss of priority in the trade dress. *In re Lawman Armor Corp.*, 2005 WL 2451654, at *2 (T.T.A.B. Sept. 16, 2005); *see also* 3 McCarthy on Trademarks and Unfair Competition § 17:28 (4th ed.). “Two marks are legally equivalent if they ‘create the same, continuing commercial impression’ and where the modified version of the mark does not ‘materially differ from or alter the character’ of the original mark.” Thus a mark is only abandoned where “the original mark been so substantially altered . . . that third parties would not expect that presently used mark to be used under and protected by the registration.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 116 U.S.P.Q.2d 1129, 1132-33 (Fed. Cir. 2015) (holding that **KELME**  and **KELME**  have the same commercial impression); *see also In re Dial-A-Mattress Operating Corp.*, 57 U.S.P.Q.2d 1807, 1812-13 (Fed. Cir. 2001) (holding that (212)-M-A-T-T-R-E-S and 1-800-M-A-T-R-E-S-S have the same commercial impression).

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] . Mr. Mieritz also opined that the minor changes made to the Tier II engines do not alter the overall appearance of the engine, and that based on his experience with OEMs

and other consumers, he believed they would be able to identify the Tier III engine with Honda. Mieritz 95:14-96:11, 247:3-249:24.

Honda's marketing materials also demonstrate that its goal was to maintain the same commercial impression with its Tier III engines. Mr. Conner testified that [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Further, the "Concept Guide's" references to [REDACTED]

[REDACTED]

[REDACTED] confirms that Honda's goal was to retain the original design concept and simply to "soften" and modernize it.

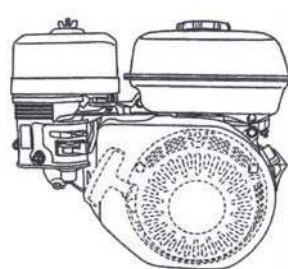
When considering whether a mark maintains the commercial impression of its predecessor, "[n]o evidence need be entertained other than the visual or aural appearance of the marks themselves." *In re Dial-A-Mattress*, 57 U.S.P.Q.2d at 1813. Below are side-by-side photographs of the Tier II engine (left), Tier III engine (middle), and the trademark publication's drawing (right). The similarities are striking:



(Applicant 66)



(Applicant 52)



(Applicant 6)

Each image displays virtually all of the styling features that comprise the GX Trade Dress: (1) the GX fuel tank has a distinct rectangular shape consisting of a straight line at the bottom of the tank, slightly angled walls (with the inside wall being more vertical than the outside wall), a horizontal seam slightly below the center of the tank, and beveled top outside edges; (2) the GX air cleaner cover includes beveled top outside edges and a horizontal belt-like area at the bottom, with the upper edge of the belt-like area

aligning with the seam on the fuel tank to create a single horizontal line that runs across the entire front surface of the engine; (3) the GX carburetor cover includes a left vertical edge, horizontal lines at the top and bottom that form right angles with the left edge, and a recessed area for the controls; and (4) the fan cover includes a slanted portion on the lower left edge, a vertical line on the upper left edge that forms a square upper left corner, a straight upper edge that flows into a semi-circular right side, and a horizontal bottom edge. *Cf.* Section V.A.

Opposers ignore all of these similarities and instead improperly attempt to narrow the GX Trade Dress to those few features that have changed, and mischaracterize the evidence to do so. Neither Mr. Conner nor Mr. Mieritz testified that only four elements of the GX Trade Dress were “distinctive and ornamental.” Opp. Br. at 53. Nor did Honda argue during prosecution that these four elements were the only “ornamental” features of the engine’s external appearance. *Id.* Rather, Mr. Mieritz testified at length about the numerous additional design elements of each engine component. Mieritz 19:25-20:11, 25:4-11, 33:9-34:3, 46:15-23. Likewise, Mr. Conner specified that [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Finally, the

prosecution history itself identifies styling elements such as “[t]he belt-like area on the lower portion of the air cleaner cover that . . . is aligned with the extruded part of the fuel tank,” and the “complementary shape of the fuel tank and air cleaner housing.” Mar. 3, 2009 Resp. to O.A.

In sum, while Honda has updated a small number of minor elements of the Tier II engine’s external appearance, the Tier III engine maintains the same commercial impression as its predecessor, and does not give rise to any abandonment of the GX Trade Dress that is the subject of the Application.

VII. CONCLUSION

As shown above, Honda’s GX Trade Dress is valid: it is nonfunctional, has acquired distinctiveness, is not generic, and has not been abandoned. Therefore Honda respectfully requests that the Board rule in its favor, and permit the mark’s registration.

**APPENDIX A: HONDA'S RESPONSE TO OPPOSERS' OBJECTIONS
TO HONDA'S EVIDENCE**

I. TESTIMONY OF JAMES MIERITZ

Honda's functionality expert, James Mieritz, worked for Opposer Briggs for over 40 years developing and testing engines (and component parts), including some that competed directly with the GX engine. Based on this extensive experience, Mr. Mieritz testified, among other things, that the stylistic features comprising the GX Trade Dress do not affect performance, cost, or quality of the engine, that competitors have numerous options to distinguish their engines without using the GX Trade Dress, and that he personally observed distributors, OEMs, and dealers readily identify the GX Trade Dress. Opposers object to two categories of testimony provided by Mr. Mieritz as lacking reliability and foundation, and request that such testimony be stricken from the record. *See* Opp. at A-1, A-10. For the following reasons, the Board should overrule this objection and deny Opposers' request.

A. Testimony Comparing Components Of The Honda GX With Components Of Other General Purpose Engines

Opposers object to Mr. Mieritz's opinions regarding the comparative performance, quality, and manufacturing cost of the GX to other general purpose engines. Although they "do not question [Mr.] Mieritz's qualifications" to render these opinions (Opp. Br. at A-2), they assert that Mr. Mieritz has not provided sufficient "analytical support" for his opinions (*id.* at A-5). Because Honda laid a proper foundation for Mr. Mieritz's opinions based on his extensive personal experience designing, developing, and testing competitor engines, the Board should overrule this objection.

Federal Rule of Evidence 702 provides that an expert witness with "scientific, technical, or other specialized knowledge" may testify in the form of an opinion if: (1) "the testimony is based upon sufficient facts or data"; (2) "the testimony is the product of reliable principles and methods"; and (3) the witness has applied the principles and methods reliably to the facts of the case." As this language makes plain, "Rule 702 specifically contemplates the admission of testimony by experts whose knowledge is based on experience." *Walker v. Soo Line R.R. Co.*, 208 F.3d 581, 591 (7th Cir. 2000); *see also Kumho Tire Co. v. Carmichael*, 526 U.S. 137, 156 (1999) ("[N]o one denies that an expert might draw a

conclusion from a set of observations based on extensive and specialized experience.”). The Advisory Committee Notes to Rule 702 explain:

Some types of expert testimony will not rely on anything like a scientific method Nothing in this amendment is intended to suggest that experience alone – or experience in conjunction with other knowledge, skill, training or education – may not provide a sufficient foundation for expert testimony. To the contrary, the text of Rule 702 expressly contemplates that an expert may be qualified on the basis of experience. In certain fields, experience is the predominant, if not sole, basis for a great deal of reliable expert testimony.

In short, “expert[] testimony is not unreliable simply because it is founded on [an expert’s] experience rather than on data.” *Metavante Corp. v. Emigrant Sav. Bank*, 619 F.3d 748, 761 (7th Cir. 2010); *see, e.g., Maiz v. Virani*, 253 F.3d 641, 668-69 (11th Cir. 2001) (holding that expert testimony on the “passport-stamping practices of Mexican immigration officials . . . based largely on [the expert’s] personal experience rather than verifiable testing or studies” was admissible); *Peoples State Bank v. Stifel, Nicolaus & Co.*, 2013 WL 1024917, at *5 (S.D. Ind. Mar. 24, 2013) (finding the methodology and reliable-facts-and-data factors of the *Daubert* inquiry “not very helpful” where expert relied principally on 25 years of experience in the industry; in such cases, the “relevant reliability concerns . . . focus upon personal knowledge or experience”); *Goldberg v. 401 N. Wabash Venture LLC*, 2013 WL 212912, at *5 (N.D. Ill. Jan 18, 2013) (rejecting defendant’s argument that expert’s “methodology is unreliable because he applies personal experience and knowledge of industry customs and practices to actions taken by [defendants],” finding that the expert’s opinion is “not inherently unsound because it is founded on his experience rather than on data”). Rather, where “the witness is relying solely or primarily on experience, then the witness must explain how that experience leads to the conclusion reached, why that experience is a sufficient basis for the opinion, and how that experience is reliably applied to the facts.” Fed. R. Evid. 702 advisory committee’s note; *accord Ge Dandong v. Pinnacle Performance Ltd.*, 2013 WL 5658790, at *14 (S.D.N.Y. Oct. 17, 2013).

Mr. Mieritz’s testimony establishes the foundation and analytical basis for his opinions comparing the GX to alternative designs offered by competitors. Mr. Mieritz is an expert in engine design who worked for Opposer Briggs for over 40 years designing and developing engines, including several

that competed directly with the GX. Mieritz 4:21-5:12, 8:10-11:1. Indeed, Mr. Mieritz led the design and development of the Vanguard engine (App. Ex. 24) that Honda relies on as one of the alternative designs to the GX Trade Dress. *Id.* at 7:19-9:17; App. Exs. 24, 41. In his various roles at Briggs (including draftsman, tool design, engine specification writer, project design engineer, assistant chief engineer, manager of large engines, manager of Vanguard engines, and business manager of Asian operations), Mr. Mieritz designed and redesigned not only complete engines, but also “virtually every component within the engine.” Mieritz 4:25-5:3, 7:14-9:17. As part of his work, manufacturing costs were a primary issue, and he worked with a cost estimator for each component of the engine to ensure he was meeting target specifications. *Id.* at 9:18-10:10. During his time at Briggs, he also became familiar with competitor engines, including the GX (*id.* at 10:11-11:1), and had actual experience with each of the engines for which he provided opinions. *Id.* at 26:13-27:15; 32:9-20; 36:18-37:23. Mr. Mieritz routinely participated in benchmark testing on competitors’ engines and components, as part of which they would “tear” the engine down and look at each component from a performance standpoint. *Id.* at 79:17-81:18. Based on this extensive knowledge and experience,¹ Mr. Mieritz testified that various third party alternative designs to the GX exist in the marketplace and that these alternative appearances have comparable performance, quality, and manufacturing costs as the GX Trade Dress. *See, e.g., id.* at 32:4-20, 32:21-33:8, 43:15-44:2, 44:23-45:25, 55:2-57:11, 68:12-69:1, 74:25-75:20.

This evidence establishes that Mr. Mieritz had ample support for his opinions comparing the general performance and costs of each component comprising the GX to its competitors based on his substantial direct experience designing engine components, analyzing manufacturing costs and incorporating such consideration of manufacturing costs into the design and development process, and

¹ Mr. Mieritz’s extensive experience developing and designing engines that compete with the GX stands in stark contrast to that of Opposers’ functionality expert, Dr. John Reisel, who has *never* designed an engine, has *never* previously analyzed the external appearance of an engine, and has seen the GX only *once, after* he was retained in this case. Reisel 72:20-21; 73:6-9; 78:1-10; 97:9-17; 116:1-8; 127:16-21. As explained in Appendix B, Dr. Reisel is not qualified to opine on the functionality of the GX Trade Dress, and his testimony should be stricken.

testing competitor engines in the ordinary course of his over 40 years of work with Briggs.² Mr. Mieritz's testimony demonstrates how his experience permitted him to arrive at the conclusions he offered regarding the comparative performance, quality, and costs of each engine component. Indeed, that Mr. Mieritz performed this testing and gained this knowledge in the ordinary course of his work as an engineer for Opposer Briggs establishes that his opinions are grounded in an accepted body of experience in the industry of engine design. *See also Reach Music Pub., Inc. v. Warner Chappell Music, Inc.*, 988 F. Supp. 2d 395, 405 (S.D.N.Y. 2013) (determining that expert testimony was sufficient where expert explained how experience led him to his opinions and how that experience is a sufficient basis for his opinion).

In sum, Opposers do not, and cannot, contest that Mr. Mieritz – unlike Prof. Reisel – is an expert in the field of small engine design and development, including the design and development of the components of such engines. Having dealt on a day-to-day basis for over 40 years with precisely the types of questions and considerations that are at issue in this case – such as whether designing an engine a particular way impacts its performance, quality, and cost; whether it is possible to make changes to the design of the engine or its components without affecting the performance, quality, or cost; and how the performance of the engines that he was designing compared with competitors' engines – Mr. Mieritz had a more than sufficient foundation to offer the opinions at issue. The Board should therefore reject Opposers' objection to Mr. Mieritz's testimony regarding the comparative performance, quality, and cost of alternative designs to the GX Trade Dress.

B. Industry Recognition Of The GX Trade Dress

Opposers also object to Mr. Mieritz's testimony that, based on his numerous conversations with OEMS, distributors, and dealers over his 40+ years in the industry, he observed that the GX was easily identified throughout the industry. Opp. Br. at A-6. Opposers assert that Mr. Mieritz is not an expert in market research, and his statements are unreliable and irrelevant lay testimony. Although Honda does not

² To the extent more detailed evidence regarding comparisons between all these engines exists, Opposers never produced such evidence, and the fact that additional analyses are possible at most goes to the weight of the evidence, not its admissibility.

present Mr. Mieritz as an expert in market research, his personal observations, gained over his decades of work on engines that compete with the GX, are both reliable and relevant to the issues in this case. *See* Fed. R. Evid. 701 (providing that lay testimony is admissible if it is “(a) rationally based on the witness’s perception; (b) helpful to clearly understanding the witness’s testimony or to determining a fact in issue; and (c) not based on scientific, technical, or other specialized knowledge within the scope of Rule 702”).

Mr. Mieritz testified that in the ordinary course of providing engineering support for sales and marketing of new engines and/or for new customers, he visited distributors approximately 10 times, OEMS approximately 20 times, and dealers over 100 times. Mieritz 96:24-97:5. He confirmed that, during such interactions, he discussed the GX, including its overall look. *Id.* at 97:6-8, 97:20-98:1. As a result of those discussions, he came to understand that the GX “was looked at and perceived as the number-one engine in the industry, with respect to performance and durability and startability,” and that the “overall look [of the GX] was easily identified throughout the industry.” *Id.* at 97:9-98:8. Specifically, individuals “were able to pick out a Honda engine versus a Briggs engine versus other engines” based on its “overall visual look from a distance.” *Id.* at 220:5-221:8. Mr. Mieritz’s extensive personal interactions with distributors, OEMs, and dealers establish the reliability of this testimony, and Opposers cannot seriously dispute that it is relevant to secondary meaning of the GX Trade Dress. As a result, the Board should overrule Opposers’ objection to the portion of Mr. Mieritz’s testimony regarding industry recognition of the GX Trade Dress.

II. APPLICANT TRIAL EXHIBITS J-M

Opposers request that the Board strike from the record Applicant Trial Exhibits J-M regarding evidence from *American Honda Motor Co., Inc. v. The Pep Boys, et al.*, 2:05-cv-08879-WDK-VBK (C.D. Cal. Nov. 13, 2007) (“*Pep Boys*”) and *PowerTrain, Inc., et al v. American Honda Motor Co., Inc.*, 1:03-cv-00688-MPM (N.D. Miss. 2007) (“*PowerTrain*”) (collectively the “GX Litigations”) because these documents are irrelevant. Opp. Br. at A8-10. For the reasons set forth below, Opposers’ request should be denied.

First, while Opposers argue that the three-dimensional trade dress asserted in the GX Litigations was “significantly different” than the applied-for mark (Opp. Br. at A9), the fact is that the three-dimensional trade dress at issue in the GX Litigations included the two-dimensional, front view of the GX that is the subject of this proceeding. [REDACTED]

[REDACTED]

[REDACTED]

In addition, Honda’s key witnesses in this proceeding regarding the development, marketing, and sale of the GX, Messrs. Conner and Fujita, also offered testimony on the same topics in the prior litigations. Conner 106:10-13; App. Ex. M at 8; Dkt. 45 at 1; Dkt. 49 at 1-2.

Second, Opposers’ claim that Applicant Exhibits J-M are “not relevant to any issue or fact in this case” is belied by their own reliance *throughout this proceeding* on the deposition testimony of Honda witnesses and documents from the GX Litigations. Opposers previously argued that the testimony of Honda’s witnesses from *Pep Boys* was not only relevant to this proceeding, but dispositive. *See, e.g.*, Dkt. 21 at 1 (“In light of this indisputable evidence originating from Honda’s production, including . . . prior litigation testimony by Honda witnesses, this matter is now ripe for a motion for summary judgment on this dispositive issue.”); Dkt. 45 at 1 (Opposers “respectfully request leave to support their motion for summary judgment . . . with *relevant and material* deposition testimony given by representatives of Applicant Honda” in the *Pep Boys* litigation.) (emphasis added) (referring to the testimony of Motohiro Fujita, Kevin Hoag, James Mieritz, and John Lally); Dkt. 49 at 2, 3 (“Attached hereto as Exhibit[s] 4 [and 15] are true and correct copies of *relevant* portions of the August 15, 2007 deposition of Motohiro Fujita . . . [and] the August 28, 2007 deposition of James Mieritz” from the *Pep Boys* litigation.) (emphasis added); Dkt. 65 at 5-6 (citing *Pep Boys* testimony from Messrs. Hoag and Mieritz). Also, Opposers previously relied on settlement agreements arising from *Pep Boys*. *See, e.g.*, Dkt. 11 at 3-6 and Daugherty Decl. at 1-2.

Further, although they now claim that the *Pep Boys* and *PowerTrain* decisions are irrelevant to this Opposition, Opposers *continue* to rely on Mr. Hoag’s testimony as well as various documents from

the GX Litigations, [REDACTED]

[REDACTED]

[REDACTED]

Opp. Exs. 29-30 (relying on Honda's survey expert, Mr. George Mantis' prior surveys in *Pep Boys* and *PowerTrain*); Opp. NOR 2 at 2 (Opposers identifying Mr. Hoag's testimony as "[e]xcerpts from a deposition taken in a prior litigation regarding the *functionality of the applied-for trademark*." (emphasis added)).

Third, in the interests of fairness and completeness, Honda should be permitted to introduce the *Pep Boys* and *PowerTrain* decisions because they provide context for the documents and testimony relied upon by Opposers. Fed. R. Evid. 106 ("If a party introduces all or part of a writing or recorded statement, an adverse party may require the introduction, at that time, of any other part – or any other writing or recorded statement – that in fairness ought to be considered at the same time."). Opposers rely, for example, on Mr. Mantis' expert report from *PowerTrain*. Opp. Ex. 29. It is therefore relevant that even though Mr. Mantis offered opinions that Opposers believe are favorable to their position, the *PowerTrain* jury concluded that Honda's trade dress had acquired secondary meaning. App. Exs. K at 1; L at 4-5.

Finally, Opposers' objection to the admission of Exhibits J-M is undercut by their failure to object to numerous exhibits relating to intentional copying of the GX Trade Dress introduced during Mr. Conner's trial testimony (some of which Opposers affirmatively rely on themselves). *See, e.g.*, App. Exs. J at 2-3 and internal Exhibit B, M at 2-3; App. Exs. 90-103; Opp. Br. at 45, 51; Conner 70:20-93:1. The *PowerTrain* permanent injunction (App. Ex. M) should not be excluded because it was separately introduced as Applicant Exhibit 91 to Mr. Conner's trial deposition in this proceeding. During his trial deposition, Mr. Conner testified about the purpose and outcome of *PowerTrain*, and authenticated Applicant Exhibit 91 as accurately describing the jury's decision in *PowerTrain*. Conner 79:8-83:7. Mr. Conner also placed the *PowerTrain* permanent injunction in context as evidence of intentional copying of Honda's trade dress, and the document itself features numerous photographs of copy engines. *See id.*; App. Ex. M internal Exhibit A at 1-5, 8, 9, 24-26, 32, 35-39, 44, 53-54. Opposers have not objected to the

introduction of Mr. Conner's testimony regarding *PowerTrain*, or to Applicant Exhibit 91. *See id.*; Opp. Br. at A8-A9. Having failed to do so in their opening brief, Opposers cannot now object to the introduction of Applicant Exhibit 91 or other evidence of intentional copying of Honda's trade dress. *See Kohler Co. v. Baldwin Hardware Corp.*, 82 U.S.P.Q.2d 1100, 1104 (T.T.A.B. 2007) ("Petitioner cannot be allowed to wait until its reply brief to maintain any objections.").

For these reasons, Honda respectfully requests that the Board deny Opposers' request to strike Applicant Trial Exhibits J-M from the record.

APPENDIX B: HONDA'S OBJECTIONS TO OPPOSERS' EVIDENCE

III. OBJECTION TO TESTIMONY OF DR. JOHN REISEL

In support of their argument that the GX Trade Dress is functional, Opposers rely on the testimony of Dr. John Reisel, a professor in mechanical engineering who has *never* designed an engine, has *never* previously analyzed the external appearance of an engine, and has seen the GX engine only *once, after* he was retained in this case.³ As explained more fully below, Honda objects to the admission of Dr. Reisel's testimony because he is unqualified to offer expert opinions regarding the functionality of the GX Trade Dress. Accordingly, Honda respectfully requests that the Board strike Dr. Reisel's testimony from the record. *See* Fed. R. Evid. 702; *Daubert v. Merrell Dow Pharm., Inc.*, 27 U.S.P.Q.2d 1200, 1203 (U.S. 1993).

A. The Testimony At Issue

Opposers rely on Dr. Reisel's testimony to support their assertions that certain aspects of the GX Trade Dress⁴ are functional, including that:

1. the GX's overall compact, cubic design is required to fit within OEM requirements; costs less as it has less parts; is more cost effective to ship as it is smaller and more engines will fit on a pallet; and is preferable in terms of easy maintenance;
2. the slanted fan cover affects engine performance as it directs cooling air toward the hottest part of the engine;
3. the positioning of the fuel tank above the carburetor is preferable as it is a gravity-fed engine and adding a pump would add cost;
4. positioning the fuel tank on the right side of the engine is necessary as it is away from the hottest part of the engine on the left;
5. positioning the air cleaner on the left side of the engine above the carburetor is necessary as the components need to be close in proximity to each other and to the air intake valve;

³ Opposers also rely on the improper opinion testimony of fact witness Jeff Whitmore. Honda continues to object to portions of Mr. Whitmore's trial testimony, as set forth in Honda's July 17, 2015 Motion to Strike Improper Expert Testimony of Fact Witness Jeff Whitmore (Dkt. 129).

⁴ As explained in Honda's trial brief, Opposers mischaracterize the GX Trade Dress to the extent they claim that it comprises solely (or even primarily) the relative location of the major components and deliberately ignore the numerous ornamental features that Honda purposefully incorporated into each of those components in order to give the engine an overall "cubic" impression.

6. placing the control levers in a recessed area on the carburetor cover reduces the need for extra parts and improves durability;
7. using a rectangular, box-shape fuel tank is preferable as that size and shape holds the most fuel;
8. adding a rib on the fuel tank is the result of the easiest and most cost-effective way to manufacture the tank;
9. adding beveling to the fuel tank is preferable as it makes it easier to remove the parts from the die during the manufacturing process; and
10. using a cubic or square shape of the air cleaner provides the most effective way to draw air around the air cleaner element.

See Opp. Br. at 36 (citing Reisel 26:5-62:8). The Board should strike Dr. Reisel’s testimony regarding each of these assertions.

B. Dr. Reisel Is Not Qualified To Opine On The Functionality Of The GX Trade Dress

An expert must be qualified by “‘knowledge, skill, experience, training, or education’ to render an opinion,” *United States v. Nacchio*, 555 F.3d 1234, 1241 (10th Cir. 2009) (*en banc*) (quoting Fed. R. Evid. 702), and the Board must “examine the credentials of the proposed expert in light of the subject matter of the proposed testimony.” *Clena Inv., Inc. v. XL Specialty Ins. Co.*, 280 F.R.D. 653, 660 (S.D. Fla. 2012) (quotations omitted). The fact that a proposed witness is an expert in one area does not mean that he is an expert in all related areas – “the opinion must be an expert opinion (that is, an opinion informed by the witness’ expertise) rather than simply an opinion broached by a purported expert.” *Ancho v. Pentek Corp.*, 157 F.3d 512, 518 (7th Cir. 1998). In other words, an expert must stay “within the reasonable confines of his subject area.” *Ralston v. Smith & Nephew Richards, Inc.*, 275 F.3d 965, 970 (10th Cir. 2001). For example, and especially relevant to this case, “an expert who is a mechanical engineer is not necessarily qualified to testify as an expert on any issue within the vast field of mechanical engineering. Unless he is to testify only to general engineering principles that any mechanical engineer would know, the engineer must possess ‘some special skill, knowledge or experience’ concerning the particular issue before the court.” *Shreve v. Sears, Roebuck & Co.*, 166 F. Supp. 2d 378, 392 (D. Md. 2001) (quoting *Ancho*, 157 F.3d at 517).

Dr. Reisel has spent almost the entirety of his mechanical engineering career as an academic researching a variety of topics, *none* of which is engine design. *See* Opp. Ex. 23 (listing research interests as including renewable energy, energy efficiency, sustainable water treatment processes, laser diagnostics of combustion processes, combustion chemical kinetics, and air pollution minimization in internal combustion engines). Dr. Reisel admitted that he: (1) *never* analyzed the external appearance of an engine in connection with any of his research (Reisel 71:22-72:4); (2) *never* studied engines and/or engine design in his undergraduate or graduate education (*id.* at 63:16-64:16); (3) did not do any research regarding engines during his post-doctoral program (*id.* at 66:16-67:20); (4) *never* designed an engine or any engine components at any point in his career (*id.* at 72:20-21); (5) *never* worked for a company that designed or manufactured engines (*id.* at 72:9-11); (6) *never* provided input to an engine manufacturer regarding the external appearance of an engine or of a fan cover, air cleaner cover, or carburetor cover (*id.* at 73:6-9, 97:9-17, 116:1-8, 127:16-21); (7) *never* taught a class addressing the external appearance of engines or “how you would set up the appearance” (*id.* at 68:6-13), or lectured on the details of the manufacturing costs of engines (*id.* at 69:21-25); (8) *never* lectured regarding horizontal shaft engines (the GX is a horizontal shaft engine) (*id.* at 69:17-20); and (9) during his *entire* education, Dr. Reisel took only *one* course regarding manufacturing processes, and has *never* otherwise studied or performed any kind of cost analysis on manufacturing options. *Id.* at 64:17-66:15.

Prior to this case, Dr. Reisel has no recollection of having heard of or seen the GX (*id.* at 77:11-25), and since being retained in this case he has seen a GX only *once*. *Id.* at 78:1-10. Indeed, Dr. Reisel could not recall having seen any of the horizontal shaft engines that are at issue in this case. *See id.* at 78:24-79:8 (Kohler Command Pro 7); 80:1-4 (Kohler Command Pro 6); 81:14-21 (Kawasaki FE250); 83:23-84:4 (Briggs & Stratton Intek 900); 84:18-24 (Subaru EX 35); 86:7-13 (Subaru EX 17); 87:1-6 (Vanguard); 88:1-8 (Kawasaki FE170); 89:3-8 (Subaru SP170); 90:2-6 (Briggs 750); 90:25-91:5 (Predator); 91:24-92:4 (Champion); 92:23-93:2 (Lifan); 93:21-94:1 (Kawasaki FJ180); 95:7-13 (All-Power). *Cf., e.g., Ralston*, 275 F.3d at 970-71 (upholding district court’s determination that a board certified orthopedic surgeon was not qualified to testify about an orthopedic device that she had never

worked with or studied); *Alfred v. Caterpillar, Inc.*, 262 F.3d 1083, 1088 (10th Cir. 2001) (rejecting expert as unqualified where the expert “conceded he had only looked at one paver during his preparation for the case, and that he had never seen a paver of the type involved in the accident or researched the control mechanisms of any types of pavers other than the one he saw”).

And although Dr. Reisel has experience researching and teaching about certain internal aspects of engines, Opposers have failed to establish that this experience provided Dr. Reisel the necessary skills, knowledge, and experience to opine regarding the purported functionality of the external appearance of an engine. For example, although Dr. Reisel teaches an elective course on internal combustion engines, he does not recall ever discussing the external appearance of an engine in this class. Reisel 15:10-21, 68:22-69:13. And although Dr. Reisel has conducted and overseen a number of research projects relating to engines, they were all directed to the performance of *vertical* shaft engines “from a pollution standpoint.” *Id.* at 12:20-15:8. Finally, Dr. Reisel was also the Associate Director for the Center For Alternative Fuels – an organization partially funded by the Wisconsin Small Engine Consortium, which various small engine companies (including Briggs & Stratton and Kohler) support (*id.* at 17:15-18:22, 76:12-18) – where he studied the effects of alternative fuels on small engines. *Id.* at 16:6-17:5. This experience does not qualify Dr. Reisel as an expert in this case – at most, Dr. Reisel periodically interacted with companies that designed and sold small engines, and “from time to time” there were discussions about design aspects of small engines. *Id.* at 18:23-19:17. Although Dr. Reisel never explained the content of these “discussions,” he acknowledged that none of his work at the Wisconsin Small Engine Consortium focused on the external appearance of any engines, and his research and publications arising out of that work have focused on emissions and/or the impact of the type of fuel being used in certain vertical shaft lawnmower engines. *Id.* at 71:3-21; *see, e.g., Pooshs v. Philip Morris USA, Inc.*, 904 F. Supp. 2d 1009, 1019 (N.D. Cal. 2012) (finding witness not qualified as expert where research and publications addressed different topic than subject of opinions).

In sum, Dr. Reisel may be an expert on engine emissions or other aspects of mechanical engineering, but such expertise has nothing to do with knowing and understanding the factors regarding

the external appearance of a horizontal shaft engine. Where Dr. Reisel has *never* designed an engine, *never* studied the external appearance of an engine, *never* addressed manufacturing costs of engine components, and – prior to being retained by Opposers – had *never* even seen any of the horizontal shaft engines that are the subject of this case, Opposers have failed to establish that Dr. Reisel possesses the specialized knowledge, skill, experience, training, or education that would qualify him to provide any opinions regarding the functionality of the external appearance of the GX. Honda therefore requests that the Board strike Dr. Reisel’s testimony.

IV. OBJECTION TO THE ADMISSION OF DOCUMENTS FROM FOREIGN TRADEMARK PROCEEDINGS

Honda objects to the admission of a European Union Office For Harmonization in the Internal Market (“OHIM”) decision and a Turkish “Precidency of Istanbul ()th Commercial Court” filing, which Opposers submitted with their First Notice of Reliance. Opp. Ex. E at 16-22, 65-81. Each of these documents is irrelevant, because it is premised on foreign trademark standards.⁵ *See Kos Pharm., Inc. v. Andrx Corp.*, 369 F.3d 700, 714, 70 U.S.P.Q.2d 1874, 1886 (3d Cir. 2004) (“Trademark standards do not traverse international borders [T]rademark rights exist in each country solely according to that country’s statutory scheme.”); *In re Universal Entm’t Corp.*, 85872412, 2014 WL 4896412, at *4 (T.T.A.B. Sept. 17, 2014) (“We take it as axiomatic that neither the trademark law of [a foreign country] nor of the United States has any extraterritorial effect.”). Accordingly, Honda respectfully requests that the Board strike these foreign trademark documents from the record.

Both the European and Turkish trademark documents are irrelevant to this United States trademark proceeding. The European OHIM decision (Opp. Ex. E at 16-22) contains solely legal conclusions regarding foreign trademark rights under foreign law, and is therefore irrelevant to the registrability of the Honda GX Trade Dress in the United States. *See E. Remy Martin & Co. v. Shaw-Ross Int’l Imports, Inc.*, 225 U.S.P.Q. 1131, 1135 (11th Cir. 1985) (“When trade-mark rights within the United

⁵ Honda included a subsequent OHIM decision in its Seventh Notice of Reliance. App. Ex. I. Honda does not intend to rely affirmatively on this document; rather, it included this exhibit to give context to Opposers’ submission.

States are being litigated in an American court, the decisions of foreign courts concerning the respective trade-mark rights of the parties are irrelevant and inadmissible.”); *see also, e.g., Otokoyama Co. v. Wine of Japan Import Inc.*, 50 U.S.P.Q.2d 1626, 1631 (2d Cir. 1999) (“[R]ights (or lack of rights) to a trademark in the United States cannot be established by the fact that [a party] was found by a foreign court to have (or not to have) rights over the same mark in a foreign country.”); *Carillon Importers Ltd. v. The Frank Pesce Grp.*, 38 U.S.P.Q.2d 1118, 1119 (S.D. Fla. 1996) *aff’d sub nom. Carillon Importers, Ltd. v. Frank Pesce Int’l Grp.*, 42 U.S.P.Q.2d 1797 (11th Cir. 1997) (“[F]oreign law is irrelevant and inadmissible in disputes over rights to marks under U.S. law.”); *Jordache Enters., Inc. v. Levi Strauss & Co.*, 30 U.S.P.Q.2d 1721, 1728 n.12 (S.D.N.Y. 1993) (“[D]ecisions of foreign tribunals concerning the trademark rights of parties [are] irrelevant.”).

Likewise, the Turkish document (a “request to have a precautionary injunction decision pursuant to Article 63 of the *Turkish Commercial Code*”) (Opp. Ex. E at 66-67) at best shows what Honda’s *Turkish* counsel believed to be significant to trademark rights *in Turkey*. *See* Opp. Ex. E at 66 (“The Client created (Annex.), introduced (Annex.) and used for the first time (Annex.) the ‘GX Series’ General Purpose Engines in Japan in 1983 and . . . [s]tarting from the beginning of 1990’s he presented it *to the taste of Turkish customers*.”). Opposers rely on the Turkish document to support their claim that customers recognize the GX as a “red, white and black” engine. Opp. Br. at 42. However, the importance of a “red, white and black” color combination to the *Turkish* market and under *Turkish* law is immaterial to Honda’s trade dress rights in the *United States*. *See E. Remy Martin & Co.*, 756 F.2d at 1531-32, 225 U.S.P.Q. at 1135 (“Our concern must be the business and goodwill attached to United States trademarks, not [foreign] trademark rights under foreign law.”).

Honda, therefore, respectfully requests that the Board strike these irrelevant and inadmissible foreign trademark documents from the record.

V. OBJECTION TO THE ADMISSION OF JAPANESE UTILITY MODEL APPLICATIONS

In support of their argument that the GX Trade Dress is functional, Opposers present a number of Japanese utility model applications, which they assert are relevant to the *Morton-Norwich* factor addressing whether a utility patent discloses the utilitarian advantages of the applied-for mark. *See* Opp. Br. at 19-23, 32-34; Opp. Exs. T-GG. Opposers provide no explanation as to why a *Japanese utility model application* should be treated the same as a *United States utility patent* in determining functionality of a *United States trademark*. Opposers: (1) do not explain the Japanese utility model system in place at the time of these applications (the 1980's); (2) do not outline the requirements for disclosures in utility model applications under Japanese law; and (3) do not compare the scope of utility models under Japanese law with utility patents under United States law. As explained more fully below, this lack of explanation is for good reason, because Japanese utility model applications have no business in a United States trademark functionality analysis. Honda therefore requests that the Board strike from the record Opposers' Exhibits T-GG as inadmissible under Federal Rules of Evidence 401 and 403.

Under the *Morton-Norwich* analysis, *United States* utility patents and utility patent applications may be relevant: “[a] utility patent is strong evidence that the features therein claimed are functional.” *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 58 U.S.P.Q.2d 1001, 1005 (U.S. 2000). The rationale for this rule is simple – “a feature that is the subject of a utility patent goes into the public domain when the patent expires,” and therefore cannot be subject to trademark protection. *In re Application of Shenango Ceramics, Inc.*, 150 U.S.P.Q. 115, 119 (C.C.P.A. 1966); *see also Valu Eng’g, Inc. v. Rexnord Corp.*, 61 U.S.P.Q.2d 1422, 1425 (Fed. Cir. 2002) (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 34 U.S.P.Q.2d 1161, 1163 (U.S. 1995)). A non-issued utility patent application may also have “evidentiary significance for the statements and claims made in the patent application concerning the utilitarian advantages” of the sought-after trademark. *See Valu Eng’g*, 61 U.S.P.Q.2d at 1429. A patent application, however, is less relevant than an issued utility patent. *See Telebrands Corp. v. Del Labs., Inc.*, 719 F. Supp. 2d 283, 300 (S.D.N.Y. 2010) (“It is logical that, under the first *Morton-Norwich* factor, the

representations in Telebrands’ rejected application weigh less towards a finding of functionality than they would if a utility patent had actually been granted.”).

These rationales for why *United States* utility patents and their applications may be relevant for functionality fall flat when applied to *foreign* patent documents. A foreign patent has no effect whatsoever in the United States, and therefore does not affect what is, or is not, in the United States’ public domain for purposes of trademark protection. Further, it should go without saying that foreign patent applications are filed and issued under completely different laws than the United States. As a result, a United States tribunal would be left to speculate regarding the significance of the patent document and the meaning and intent of any statements contained in a foreign patent. *See, e.g., Franek v. Walmart Stores, Inc.*, 2009 WL 674269, at *14 (N.D. Ill. Mar. 13, 2009) *aff’d sub nom. Jay Franco & Sons, Inc. v. Franek*, 96 U.S.P.Q.2d 1404 (7th Cir. 2010) (“[T]he Court would be reluctant to extend *TrafFix* to the consideration of foreign patents without any supporting precedent”). And a tribunal would have even less assurance with a foreign application that never issued.

The problems presented by foreign patent documents are especially significant in this case. Opposers do not rely on foreign utility *patents*, but rather foreign utility *model applications which they have not established ever issued*. The United States has no analogous patenting scheme for utility models, which the Japan Patent Office administers and issues “for something less of an inventive step than a patent registration.” Andrew H. Thorson & John A. Forkort, Japan’s Patent System: An Analysis of Patent Protection Under Japan’s First-to-File System, 77 J. Pat. & Trademark Office Soc’y 291, 298 (1995); *see also* Japan Patent Office, “Utility Model,” available at <https://www.jpo.go.jp/english/faqs/utility-model.html> (last accessed Jan. 9, 2016) (explaining that “the words ‘invention’ (i.e., reflecting ‘high creativity’ [for a patent]) and ‘device’ (i.e., reflecting ‘creativity’ [for a utility model]) are used for ideas involving different levels of creativity.”). Nothing on the face of these utility model applications indicates that they issued (despite Opposers’ assertions to the contrary, *see* Opp. Br. at 19-22). Indeed, some even explicitly state that they are “unexamined.” *See* Opp. Exs. U-Y, CC. Thus, at most, Opposers have established that the applications were published, and that some of

them may have been examined. *See, e.g.,* Opp. Ex. AA. But publication and/or examination, standing alone, does not establish issuance. Rather, under Japan’s system at the time of these utility model applications (the 1980’s), applications were published at two different times (18 months after the filing date and again after examination), and the decision whether to grant the application was made sometime after both these publication dates. European Patent Office, “Patent granting procedure in Japan (old law, prior to 1996),” *available at* [http://documents.epo.org/projects/babylon/eponet.nsf/0/92619E02543AE153C1257241005CDE0C/\\$File/grant_procedure_patents_1996prior_en.gif](http://documents.epo.org/projects/babylon/eponet.nsf/0/92619E02543AE153C1257241005CDE0C/$File/grant_procedure_patents_1996prior_en.gif) (last accessed Jan. 12, 2016).

Thus, the Japanese utility model applications presented by Opposers: (1) are not subject to United States law; (2) are subject to a utility model system completely different from the utility patent system under United States law; and (3) may have never issued or even been examined. These significant differences between the Japanese utility model applications presented by Opposers, and the United States utility patents and applications that tribunals may consider under the *Morton-Norwich* analysis, preclude the Board from drawing any reasonable inference that the disclosures in Opposers’ Exhibits T-GG are relevant to functionality. Fed. R. Evid. 401. Indeed, to determine the relevance of any disclosures in these exhibits, the Board would need to analyze the Japan utility model system in place at the time of these applications (the 1980’s), determine the requirements for disclosures in utility model applications, and compare the scope of utility models under Japan law with utility patents under United States law. *See also* Nabuo Monya, Revision of the Japanese Patent and Utility Model System, 3 Pac. Rim L. & Pol’y J. 227, 241-42 (1994) (explaining revisions to Japan utility model system). As this process makes clear, any arguable probative value these exhibits have is substantially outweighed by the danger of confusing the issues and wasting the Board’s time to conduct the necessary analysis. *See* Fed. R. Evid. 403. As a result, Honda requests that the Board strike Opposers’ Exhibits T-GG from the record.

**APPENDIX C: TESTIMONY COMPARING THE GX TRADE DRESS
TO ALTERNATIVE DESIGNS**

Engine	Applicant Trial Ex. No(s).	Testimony
Honda GX	6, 52, 66, 73-75, 87	<ul style="list-style-type: none"> • <u>Fuel tank</u>: Fujita 26:13-30:13; Mieritz 19:19-20:11 • <u>Air cleaner cover</u>: Fujita 36:5-37:22; Mieritz 46:15-47:4 • <u>Carburetor cover</u>: Fujita 40:14-41:19 • <u>Location of controls</u>: Fujita 40:14-41:19 • <u>Fan cover</u>: Fujita 44:11-45:12; Mieritz 33:9-34:3 • <u>Overall look</u>: Mieritz 69:21-71:16
All Power 208cc	32	<ul style="list-style-type: none"> • <u>Air cleaner cover</u>: Reisel 126:8-16 • <u>Carburetor and controls</u>: Reisel 130:15-20
Blue Max	104	<ul style="list-style-type: none"> • <u>Overall look</u>: Conner 100:7-101:6
Briggs 750 Series	27	<ul style="list-style-type: none"> • <u>Fuel tank</u>: Reisel 113:20-114:1 • <u>Carburetor and controls</u>: Reisel 129:3-11 • <u>Overall look</u>: Hotz 140:10-20 (“Briggs look”); App. Ex. B, Rumao 169:18-170:11 (same)
Briggs Intek 900	21	<ul style="list-style-type: none"> • <u>Fuel tank</u>: Mieritz 28:22-21, 32:4-33:8; Reisel 111:5-16 • <u>Air cleaner cover</u>: Mieritz 53:6-24; Reisel 122:1-12 • <u>Carburetor cover</u>: Mieritz 60:9-13, 63:3-63:14 • <u>Location of controls</u>: Mieritz 65:20-67:2; Reisel 135:7-10 • <u>Fan cover</u>: Mieritz 38:12-39:6, 43:21-45:5; Reisel 101:6-13 • <u>Top lines of engine</u>: Reisel 145:23-146:8 • <u>Overall look</u>: Mieritz 84:5-85:10; <i>see also</i> Hotz 140:10-20 (“Briggs look”); App. Ex. B, Rumao 169:18-170:11 (same)
Briggs Vanguard 9hp	24	<ul style="list-style-type: none"> • <u>Fuel tank</u>: Mieritz 29:22-31:4, 32:4-33; Reisel 105:24-7, 113:9-18 • <u>Air cleaner cover</u>: Mieritz 55:2-57:11; Reisel 123:10-22

Engine	Applicant Trial Ex. No(s).	Testimony
		<ul style="list-style-type: none"> • <u>Carburetor and controls</u>: Reisel 128:15-19, 135:11-14 • <u>Overall look</u>: Mieritz 86:20-88:15; <i>see also</i> Hotz 140:10-20 (“Briggs look”); App. Ex. B, Rumao 169:18-170:11 (same)
Champion 338CC	29	<ul style="list-style-type: none"> • <u>Fuel tank</u>: Reisel 113:20-114:1 • <u>Air cleaner cover</u>: Reisel 125:4-22 • <u>Fan cover</u>: Reisel 103:16-19 • <u>Overall look</u>: Conner 97:5-98:1
Generac	105	<ul style="list-style-type: none"> • <u>Overall look</u>: Conner 101:14-102:9
Kawasaki FE170	25	<ul style="list-style-type: none"> • <u>Air cleaner cover</u>: Reisel 123:23-124:7 • <u>Location of controls</u>: Reisel 135:15-19 • <u>Fan cover</u>: Reisel 102:3-102:11
Kawasaki FE250	20, 43	<ul style="list-style-type: none"> • <u>Fuel tank</u>: Mieritz 31:5-32:3, 32:4-33:8; Reisel 105:14-23, 110:9-111:4, 153:12-19 • <u>Air cleaner cover</u>: Reisel 121:16-25 • <u>Location of controls</u>: Reisel 135:1-4 • <u>Fan cover</u>: Mieritz 40:5-41:25 • <u>Overall look</u>: Mieritz 88:16-90:17
Kawasaki FJ180	31	<ul style="list-style-type: none"> • <u>Fuel tank</u>: Reisel 113:20-114:1 • <u>Carburetor and controls</u>: Reisel 130:6-13 • <u>Fan cover</u>: Reisel 103:20-23 • <u>Top lines of engine</u>: Reisel 146:9-25
Kohler Command Pro 6	19, 44, A5	<ul style="list-style-type: none"> • <u>Fuel tank</u>: App. Ex. A, Hotz 100:3-101:8 • <u>Air cleaner cover</u>: App. Ex. A, Hotz 101:9-105:18 • <u>Carburetor cover</u>: Mieritz 62:4-63:2, 63:3-63:14

Engine	Applicant Trial Ex. No(s).	Testimony
		<ul style="list-style-type: none"> • <u>Location of controls</u>: Reisel 128:7-13 • <u>Fan cover</u>: Mieritz 41:1-25 • <u>Overall look</u>: Mieritz 90:18-92:12; App. Ex. B, Rumao 31:18-32:7 (describing Command look)
Kohler Command Pro 7	17, 36, A4	<ul style="list-style-type: none"> • <u>Fuel tank</u>: Mieritz 27:25-21, 32:4-33:8; Reisel 109:23-110:8; Litt 117:23-118:15; App. Ex. A, Hotz 92:16-93:12 • <u>Air cleaner cover</u>: Mieritz 52:12-53:5; Reisel 121:3-15; Litt 116:22-117:22; App. Ex. A, Hotz 93:13-95:18 • <u>Carburetor cover</u>: Mieritz 60:19-61:10, 63:3-63:14; Litt 118:16-22; Reisel 165:12-166:9; App. Ex. A, Hotz 95:19-96:14 • <u>Location of controls</u>: Mieritz 65:20-67:2 • <u>Fan cover</u>: App. Ex. A, Hotz 96:15-98:5 • <u>Overall look</u>: Mieritz 83:4-84:4; Litt 26:22-27:14, 116:14-21, 118:23-119:8; App. Ex. B, Rumao 31:18-32:7 (describing Command look)
Lifan 190F	30	<ul style="list-style-type: none"> • <u>Fuel tank</u>: Reisel 113:20-114:1 • <u>Air cleaner cover</u>: Reisel 125:23-126:7 • <u>Overall look</u>: Conner 98:7-99:9
Predator 346cc	28	<ul style="list-style-type: none"> • <u>Air cleaner cover</u>: Reisel 124:20-125:3 • <u>Carburetor and controls</u>: Reisel 129:12-19
Subaru EX35	22	<ul style="list-style-type: none"> • <u>Fuel tank</u>: Reisel 111:17-112:21 • <u>Air cleaner cover</u>: Reisel 122:13-21 • <u>Fan cover</u>: Reisel 101:14-21
Subaru EX 17	23, A1	<ul style="list-style-type: none"> • <u>Fuel tank</u>: Reisel 112:22-113:8; App. Ex. A, Hotz 109:11-110:6 • <u>Air cleaner cover</u>: Mieritz 53:25-55:1; Reisel 121:22-123:9; App. Ex. A, Hotz 110:7-111:5 • <u>Carburetor cover</u>: Mieritz 61:11-62:3, 63:3-63:14; App. Ex. A, Hotz 111:6-21

Engine	Applicant Trial Ex. No(s).	Testimony
		<ul style="list-style-type: none"> • <u>Fan cover</u>: Mieritz 39:7-40:4; Reisel 101:22-102:2; App. Ex. A, Hotz 111:22-112:16 • <u>Overall look</u>: Mieritz 85:11-86:20; Conner 94:21-96:6
Subaru SP-170	26	<ul style="list-style-type: none"> • <u>Fuel tank</u>: Reisel 113:20-114:1 • <u>Air cleaner cover</u>: Reisel 124:8-19 • <u>Carburetor and controls</u>: Reisel 128:20-129:2 • <u>Fan cover</u>: Reisel 102:12-103:15 • <u>Overall look</u>: Conner 96:10-97:1
Yamaha MZ360	51	<ul style="list-style-type: none"> • <u>Overall look</u>: Mieritz 92:11-95:13

APPENDIX D: INDEX OF TRIAL EXHIBITS

EXHIBITS TO TRIAL TESTIMONY

Applicant Trial Exhibits	Opposer Trial Exhibits	Witness
1-9	1-12	Jeff Whitmore
10-18	13-22	Cameron Litt
19-40	23-25	John Reisel
41-52	26-28	James Mieritz
53-65	29-30	George Mantis
66-105	31-62	Steven Scott Conner
106-111	63-76	Hal Poret
187-195		Motohiro Fujita

INDEX OF EXHIBITS TO APPLICANT'S NOTICES OF RELIANCE

Trial Exhibit	Notice of Reliance	Description
A	1	Excerpts of March 26, 2014 discovery deposition of 30(b)(6) witness Peter Hotz
A1	1	Black and white, unlabeled photograph of Subaru EX17 Engine
A2	1	Honda's amended 30(b)(6) deposition notice
A3	1	Black and white, unlabeled Honda GX Engine
A4	1	Black and white, unlabeled Kohler Command Pro 6 Engine
A5	1	Black and white, unlabeled Kohler Command Pro 7 Engine
A6	1	Black and white, unlabeled Subaru EX35 Engine
A7	1	Briggs styling design document
A8	1	Briggs styling design document
A9	1	Line drawing from Honda's trademark application
A10	1	U.S. Patent No. D689,522
A11	1	U.S. Patent No. D309,458
A12	1	U.S. Patent No. D595,737
A13	1	Briggs financial document
A14	1	Briggs financial document
A15	1	Black and white, unlabeled Briggs Intek Engine
A16	1	Black and white, unlabeled Vanguard 9HP Engine
B	2	Excerpts of March 28, 2014 discovery deposition of Manuel Rumao
B1	2	Black and white, unlabeled photograph of Subaru EX17 Engine
B2	2	Photograph of Kohler SH265 Engine
B3	2	July 19, 2007 email regarding "GPE Horizontal Update"
B4	2	Black and white, unlabeled Honda GX Engine
B5	2	Black and white, unlabeled Kohler Command Pro 6 Engine
B6	2	January 5, 2009 email regarding "Courage Horizontal series usage"
B7	2	Kohler marketing plan document
B8	2	October 22, 2009 email regarding "SH265 fuel tank"
B9	2	Kohler engines presentation document
B10	2	Black and white, unlabeled Briggs Intek Engine
B11	2	Kohler styling design document
C	3	Briggs' Second Supplemental Responses to Applicant's First Set of Interrogatories
D	3	Briggs' Supplemental Responses to Applicant's Second Set of Interrogatories
E	4	Kohler's Second Supplemental Responses to Applicant's First Set of Interrogatories
F	4	Kohler's Responses to Applicant's Second Set of Interrogatories
G	5	Briggs' Responses to Applicant's First Set of Requests for Admission
H	6	Kohler's Responses to Applicant's First Set of Requests for Admission
I	7	OHIM Certificate of Registration for Trade Mark No. 003365988
J	8	Permanent Injunction Order, <i>PowerTrain, Inc., et al. v. American Honda Motor, Co., Inc.</i> , 1:03-cv-00688-MPM (N.D. Miss. Oct. 23, 2007)
K	8	Jury Verdict, <i>PowerTrain, Inc., et al. v. American Honda Motor, Co., Inc.</i> , 1:03-cv-00688-MPM (N.D. Miss. Aug. 13, 2007)
L	8	Jury Instructions, <i>PowerTrain, Inc., et al. v. American Honda Motor, Co., Inc.</i> , 1:03-cv-00688-MPM (N.D. Miss. Aug. 21, 2007)

Trial Exhibit	Notice of Reliance	Description
M	8	Summary Judgment Order, <i>American Honda Motor Co., Inc. v. The Pep Boys, et al.</i> , 2:05-cv-08879-WDK-VBK (C.D. Cal. Nov. 13, 2007)
N	9	Excerpts of December 10, 2014 discovery deposition of Motohiro Fujita
N1	9	Pages from Honda website
O	10	Excerpts of Expert Report of Kevin Hoag in <i>American Honda Motor Co., Inc. v. The Pep Boys, et al.</i> , 2:05-cv-08879-WDK-VBK (C.D. Cal. Nov. 13, 2007)
P	10	Excerpts of August 23, 2007 Deposition of Kevin Hoag in <i>American Honda Motor Co., Inc. v. The Pep Boys, et al.</i> , 2:05-cv-08879-WDK-VBK (C.D. Cal. Nov. 13, 2007)
Q	11	Shari Seidman Diamond, Reference Guide on Survey Research, in Reference Manual on Scientific Evidence (2d Ed. Federal Judicial Center 2000)
R	11	Shari Seidman Diamond, Reference Guide on Survey Research, in Reference Manual on Scientific Evidence (3d Ed. Federal Judicial Center 2011)

INDEX OF EXHIBITS TO OPPOSERS' NOTICES OF RELIANCE

Trial Exhibit	Notice of Reliance	Description
A	1	Briggs' First Set of Requests for Admission and Responses
B	1	Briggs' Second Set of Requests for Admission and Responses
C	1	Briggs' Fourth Set of Requests for Admission and Responses
D	1	Briggs' Fifth Set of Requests for Admission and Responses
E	1	Briggs' Sixth Set of Requests for Admission and Responses
F	1	Applicant's Supplemental Responses to Briggs' Fifth Set of Requests for Production of Documents
G	2	Internet pages
H	2	Internet pages
I	2	Excerpts of August 23, 2007 Deposition of Kevin Hoag in <i>American Honda Motor Co., Inc. v. The Pep Boys, et al.</i> , 2:05-cv-08879-WDK-VBK (C.D. Cal. Nov. 13, 2007)
J	3	May 29, 2014 discovery deposition of Yukio Sugimoto
J1	3	Deposition notice
J2	3	Email regarding "GX Mid Model Change Video Conference Proposal"
J3	3	Honda sales document
J4	3	Email regarding "Mid GX"
J5	3	Business card of Yukio Sugimoto
J6	3	Photo of Generac power product
J7	3	Line drawing of Honda GX Engine
K	4	Excerpts of February 26, 2014 discovery deposition of John Lally
K1	4	Photograph of Briggs 550 Series Engine
K2	4	Black and white, unlabeled photograph of Subaru EX17 Engine
K3	4	Press releases and letters
K4	4	Screenshot from "Marketing Information on Demand"
K5	4	Screenshot from "Marketing Information on Demand"
K6	4	Email regarding "Submission of Redesign"
K7	4	Internet pages
K8	4	Advertising presentation document
K9	4	Advertising presentation document
K10	4	Screenshot from "European Engine Center Advertising"
K11	4	Screenshot of "Honda Worldwide – News Releases 2013"
K12	4 (Supp.)	Signature page from deposition transcript
K13	4 (Supp.)	Honda's trademark application
K14	4 (Supp.)	Opposers' First Set of Requests for Admission
K17	4 (Supp.)	Honda document regarding the Tier III engine
K18	4 (Supp.)	Photos of the Honda GX Engine
K19	4 (Supp.)	Honda advertisement
K20	4 (Supp.)	Honda advertisement
K21	4 (Supp.)	Honda advertisement
K22	4 (Supp.)	Honda advertisement
K23	4 (Supp.)	Honda advertisement
K24	4 (Supp.)	Honda advertisement

Trial Exhibit	Notice of Reliance	Description
K25	4 (Supp.)	Honda advertisement
K26	4 (Supp.)	Honda advertisement
K27	4 (Supp.)	Honda advertisement
K28	4 (Supp.)	Honda brochure
K29	4 (Supp.)	Honda brochure
K30	4 (Supp.)	Honda advertisement
K31	4 (Supp.)	Honda advertisement
L	5	Excerpt of December 10, 2014 discovery deposition of Motohiro Fujita
L1	5	GX Engine line drawing
M	6	U.S. Patent No. 4,813,385
N	6	U.S. Patent No. 6,362,533
O	6	U.S. Patent No. 6,489,690
P	6	U.S. Patent No. 6,331,740
Q	6	U.S. Patent No. 6,941,919
R	6	U.S. Patent No. 6,525,430
S	6	U.S. Patent No. 7,086,389
T	6	Japanese utility model application/publication No. H03-13535 – with translation
U	6	Japanese utility model application/publication No. S57-30407 – with translation
V	6	Japanese utility model application/publication No. S58-156124 – with translation
W	6	Japanese utility model application/publication No. S59-40536 – with translation
X	6	Japanese utility model application/publication No. S59-59577 and Application
Y	6	Japanese utility model application/publication No. S59-62263 – with translation
Z	6	Japanese utility model application/publication No. S62-18699 – with translation
AA	6	Japanese utility model application/publication No. S62-31640 – with translation
BB	6	Japanese utility model application/publication No. S62-33961 – with translation
CC	6	Japanese utility model application/publication No. S62-126264 – with translation
DD	6	Japanese utility model application/publication No. S63-27046 – with translation
EE	6	Japanese utility model application/publication No. S63-32344 – with translation
FF	6	Japanese utility model application/publication No. S63-35160 – with translation
GG	6	Japanese utility model application/publication No. S63-46266 – with translation
LL	7	Excerpts of March 28, 2014 discovery deposition of Manuel Rumao
MM	7	Honda GX Engine line drawing
OO	8	Excerpts of August 23, 2007 Deposition of Kevin Hoag in <i>American Honda Motor Co., Inc. v. The Pep Boys, et al.</i> , 2:05-cv-08879-WDK-VBK (C.D. Cal. Nov. 13, 2007)
PP	9	Excerpts of March 26, 2014 discovery deposition of 30(b)(6) witness Peter Hotz
PP1	9	Photograph of Honda GX Engine
PP2	9	Internet pages
QQ	10	Excerpts of August 9-10, 2014 discovery deposition of Steven Scott Conner
QQ1	10	Deposition notice
QQ2	10	Honda brochure
RR	11	Shari Seidman Diamond, <i>Control Foundations: Rationales and Approaches, Trademark and Deceptive Advertising Surveys, Law, Science and Design</i> (2012)
SS1	12	Documents from prosecution history of U.S. Patent No. 4,813,385

Trial Exhibit	Notice of Reliance	Description
SS2	12	Documents from prosecution history of U.S. Patent No. 4,813,385
TT	13	Internet pages
UU	14	Internet pages
VV	14	Internet pages
WW	14	Internet pages
XX	14	Internet pages
YY	14	Internet pages
ZZ	14	Internet pages
AAA	14	Internet pages
BBB	14	Internet pages
CCC	14	Internet pages
DDD	14	Internet pages

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Applicant Honda Giken Kogyo Kabushiki Kaisha's Trial Brief has been served on the following counsel of record by depositing same in the U.S. Mail, first class postage prepaid this 13th day of January, 2016:

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